134

No. 09-

Supreme Court, U.S.
FILED
09-97 JUL 22 2009
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

STEVEN D. RITCHIE and H. DAVID REYNARD
(as Trustee for the Harlie David Reynard, Jr.
Revocable Trust),

Petitioners,

v.

VAST RESOURCES, INC.
(doing business as Topco Sales),

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNTIED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

EDWARD P. DUTKIEWICZ
P.O. Box 937
Dade City, FL 33526
(352) 467-2682

Counsel for Petitioners

224021

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

QUESTIONS PRESENTED

(1) Did the Federal Circuit Panel err in not considering all relevant evidence of non-obviousness in reaching its decision of invalidity based on obviousness.

(2) Must the Federal Circuit Court of Appeals Panel explicitly address, and carefully attend to all relevant evidence of non obviousness, such as secondary consideration in reaching a judgement of obviousness.

(3) Whether the Supreme Court will address the inconsistencies within the opinions of the Federal Circuit and inconsistencies with Supreme Court Case law, where the Federal Circuit found error when the District Court below failed;

(a) to give due weight to the nature of the problem to be solved and common sense as required in *Andersen Corp. v. Pella Corp.*, 300 Fed.Appx. 893, 895, C.A.Fed. (Minn. 2008); *see also Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 276 U.S. (1944), in that the Panel, in this case, did not discuss any problem solved by the invention;

(b) to make mention or discuss relevant evidence of the secondary considerations as required and. set forth in *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 667, C.A.Fed. (Mo. 2000);

(c) to focus on the indications of non obviousness, as required by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 14 (1966); and

(d) to explain the rationale for finding the patent obvious absent any evidence of any rational underpinning which would support the legal conclusion of obviousness, as required by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741.

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED	i
TABLE OF CONTENTS	iii
TABLE OF APPENDICES	iv
TABLE OF CITED AUTHORITIES	v
OPINION BELOW	1
CITATIONS	1
STATEMENT OF JURISDICTION	2
STATUTORY PROVISIONS INVOLVED	3
STATEMENT OF THE CASE	6
REASONS FOR GRANTING THE PETITION	7
CONCLUSION	17

TABLE OF APPENDICES

Page

Appendix A — Opinion Of The United States Court Of Appeals For The Federal Circuit Decided April 24, 2009 ..... 1a

Appendix B — Amended Final Order Of The United States District Court For The Middle District Of Florida, Tampa Division Dated July 24, 2008 ..... 8a

Appendix C — Order Of The United States Court Of Appeals For The Federal Circuit Denying Petition For Rehearing Dated And Filed June 25, 2009 ..... 59a

Appendix D — Relevant Statutes 61a

TABLE OF CITED AUTHORITIES

Page

Cases:

Andersen Corp. v. Pella Corp.,
300 Fed.Appx. 893, C.A.Fed. (Minn. 2008) ... i, 12, 13

Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.,
321 U.S. 275 (1944) ..... i, 15, 16

Graham v. John Deere Co. of Kansas City,
383 U.S. 1 (1966) ..... i, 10, 12, 13, 14, 15

KSR Int'l Co. v. Teleflex Inc.,
127 S.Ct. 1727 (2007) ..... ii, 12, 16

Richardson-Vicks Inc. v. Upjohn Co.,
122 F.3d 1476, C.A. Fed. (1997) 13

Ritchie v. Vast Resources,
Nos. 2008-1528 (Fed. Cir. 2009) 1

Ruiz v. A.B. Chance Co.,
234 F.3d 654, C.A.Fed. (2000) ..... i, 12, 13

Steven D. Ritchie, et al. v. Vast Resources, Inc.,
No. 8:06-CV-218-T26TGW (M.D. Fla. 2008) ... 1

Stratoflex, Inc. v. Aeroquip Corp.,
713 F.2d 1530, C.A.Fed. (1983) 10, 11

Cited Authorities

Page

Statutes:

15 U.S.C. § 1121 6

18 U.S.C. § 1292 6

28 U.S.C. § 1331 6

28 U.S.C. § 1338 6

28 U.S.C. § 1338(a)-(b) 6

35 U.S.C. § 103 3

35 U.S.C. § 271 *et seq.* 6

OPINION BELOW

The Petitioners seek to have the following Orders of the Federal Circuit Court of Appeals reviewed:

JUDGEMENT, issued April 25, 2009

ORDER DENYING RE-HEARING, issued June 25, 2009.

CITATIONS

1. Opinion of the of the Federal Circuit Court of Appeals, decided April 24, 2009, issued as a Mandate on July 2, 2009 in *Ritchie v. Vast Resources*, Nos. 2008-1528, -1529 (Fed. Cir. 2009).

2. Order of the Federal Circuit Court of Appeals denying a rehearing or a rehearing en banc, issued June 25, 2008 in *Ritchie v. Vast Resources*, Nos. 2008-1528, -1529 (Fed. Cir. 2009).

3. The Federal Circuit reversed the Amended Final Order of the District Court for the Middle District of Florida, Judge Richard A. Lazzara, issued July 24, 2008 in *Steven D. Ritchie, et al. v. Vast Resources, Inc.*, No. 8:06-CV-218-T26TGW (M.D. Fla. 2008).

See Appendices A-C.

STATEMENT OF JURISDICTION

The Petitioners submit that jurisdiction of the Supreme Court is proper under the Supreme Court's Rule 10, in that the Federal Circuit Court of Appeals has entered a decision in conflict with the decision of another United States court of appeals on the same important matter; and that the Federal Circuit Court of Appeals findings and decision has decided the issue of obviousness in a manner which has so far departed from the accepted and usual course of judicial proceedings as set forth in the case law of both the Federal Circuit Court of Appeals and the United States Supreme Court, or sanctioned such a departure by a lower court, as to call for an exercise of this Court's supervisory power. The date of the judgement entered by the Federal Circuit Court of Appeals is April 24, 2009. The Federal Circuit Court of Appeals also denied the Petitioners' Petition for a Re-hearing, and a Re-hearing en banc. The order denying the Re-hearings is dated June 25, 2009.

The Petitioners believe that the Court's jurisdiction is conferred under 28 U.S.C. § 1254(1) review of decision of a court of appeals, and Rule 14 of the Supreme Court Rules.

STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 103. Conditions for patentability; non-obvious subject matter

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(b)(1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if— (A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and (B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1)—

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.

(3) For purposes of paragraph (1), the term "biotechnological process" means—

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to—

(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

(c) (1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if—

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

> (C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.
>
> (3) For purposes of paragraph (2), the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

Other relevant statutes: 35 U.S.C. § 271 *et seq.*; 15 U.S.C. § 1121; 28 U.S.C. § 1338; 28 U.S.C. § 1338(a)-(b); 18 U.S.C. § 1292 (*See* Appendix D).

STATEMENT OF THE CASE

The Petitioners brought suit for infringement of reissued patent RE38,924, which issued on December 20, 2005. Jurisdiction of the District Court was proper under 35 U.S.C. § 271 *et seq.*, 15 U.S.C. § 1121, 28 U.S.C. § 1331 and 28 U.S.C. § 1338(a)-(b), as it involves substantial claims arising under the United States Patent Act of 1952, as amended, and 35 U.S.C. § 271 *et seq.*

After a bench trial, the Court found for the Petitioners, adjudging that the Defendant, Vast Resources, Inc. infringed the '924 patent (*see* Amended Judgement). Both parties appealed to the Federal Circuit Court of Appeals. Jurisdiction of the Federal Circuit Court of Appeals was proper under 18 U.S.C. § 1292 of this matter as it was an appeal from an final order of a federal district court involving orders and judgments arising from a dispute concerning an issued patent.

The Petitioners appealed the claims construction and denial of damages, the Defendant, Respondent appealed validity, among other issues. After oral argument the Federal Circuit Panel decided the matter, rendering its opinion on April 24, 2009. The Panel reversed the District Court as to validity, holding the patent to be obvious (see; Order of Federal Circuit Court of Appeals).

The Petitioners petitioned for a re-hearing and/or a re-hearing en banc in a timely fashion. The petitions for re-hearing were both denied on June 25, 2009 (*see* Order of Federal Circuit Court of Appeals). The judgment of the Panel was issued as a mandate on July 2, 2009. The Petitioners filed this Petition for Certiorari in a timely manner.

REASONS FOR GRANTING THE PETITION

Question (1)

(1) Did the Federal Circuit Panel err in not considering all relevant evidence of non-obviousness in reaching its decision of invalidity based on obviousness.

Question (1) Argument

Petitioners briefed several of the secondary considerations in countering Vast Resources, Inc.'s (hereinafter "VRI") arguments of obviousness. The Petitioners, Ritchie and Reynard (hereinafter "Ritchie") demonstrated to the Court the evidence of unexpected results, (the borosilicate glass aids having superior temperature resistance, lubricity and chemical resistance) commercial success (300,000 web site search

hits for glass sex aids compared with 1.2 million web search hits for "Ford Motor Company and VRI admitted to $700,000 of sales in just over one year's time"), a solution to a problem which was found through the industry (odor retention and tissue pulling, which was not addressed by the industry), copying by others (all glass sex aids are borosilicate, and a vast majority of the sex aids on the market infringe the'924 patent) and acceptance by the marketplace (the borosilicate glass sex aid market did not exist until after the patentees entered the market place with their devices).

The Panel recognized that the use of borosicilicate glass to make a sex aid did not occur for over one hundred years after borosilicate glass was invented, in 1893, which indicated unobviousness. The Panel alluded to "skillful marketing" to argue against the commercial value, though there had been no evidence or testimony offered regarding "skillful marketing".

The Panel discussed "modest, routine, everyday, incremental improvements of an existing product or process that confer commercial value, absent any evidence, either as testimony or introduced evidence, as to any such "incremental improvements".

The Panel discussed KSR, quoting discussion of "design incentives and other market forces [which may] prompt variations of [a device]. However, there was no testimony or evidence available which related to "design incentives and other market forces", with the testimony being exactly opposite of the existence of any design incentives or market forces which would prompt the invention. Nonetheless, the Panel speculated on the

effect of skillful marketing in addressing the secondary consideration of commercial success.

The Panel discussed those issues which had not been presented at trial, and omitted all the evidence of secondary considerations which had been presented at trial, such as;

(i) market success: the evidence showed that there were no borosilicate glass (BSG) sex aid products or vendors before the introduction by the patentees, and that the entire industry occurred after the introduction of the BSG sex aid by the patentees (Ritchie Reply Brief (RRB); p 19-21, *see also* (Fed.Cir. Appendix 3172;6-20));

(ii) copying by others: the evidence showed that since the introduction of BSG sex aids by the patentees, there has been a great influx of devices in the marketplace, with a "vast majority" of the devices falling within the claims of the patent at issue. During the hearing, counsel for Topco/Appellee stated that virtually all sex aids in the market place are made of BSG (Ritchie Reply Brief, pgs 20-21, (Fed.Cir. Appendix 3172;6-20));

(iii) one skilled in the art: was defined as one who was not aware of the properties of BSG, though the District Court found that one skilled in the art was aware of the properties (Ritchie Reply Brief, p 22, and Ritchie Initial Brief, p 33-36; see also (Fed.Cir. Appendix (3493; L2-6) and (3582; L6-19));

(iv) absence of any market forces to effectuate change: the evidence shows that the market place was not engaged in any research, and that there were no

grounds for finding that one skilled in the art would have a problem to solve with the use of BSG (Ritchie Reply Brief, pgs 17-18);

(v) the patentees identified a shortcoming of the prior art, and addressed those shortcomings with the introduction of BSG for the manufacture of sex aids (Ritchie Reply Brief, pgs 13-14), *see also* (Fed.Cir. Appendix 3041;8-3044;5);

(vi) the failure of others to make devices having the qualities of the BSG sex aid, such as resistance to heat, chemicals, electricity and bacterial absorption (Counsel's statement to the Panel that virtually all sex aids are made of BSG);

(vii) the prior art teaches away from the present invention (Ritchie Reply Brief, pgs 12-15); and

(viii) the unexpected results which flowed from the use of BSG, providing a device which was resistant to heat, chemicals, electricity and bacterial absorption (Ritchie Reply Brief, pgs 16-18).

Graham v. Deere, requires that the Court direct the focus of the investigation on the indicators of non obviousness, the so-named "secondary considerations". In Graham, the Supreme Court stated, "that Congress has emphasized nonobviousness as the operative test of the section" *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 14, U.S. __ (1966). The Federal Circuit explicitly required the consideration of all evidence of secondary considerations in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1358-59, C.A.Fed., (1983). However,

the Panel did not address or evaluate any of the secondary considerations in its discussion of the rationale for its judgement. In doing so, the Federal Circuit Panel has taken an opposite course of analysis from that mandated by the Federal Circuit in the Stratoflex case.

Question (2)

(2) Must the Federal Circuit Court of Appeals Panel explicitly address, and carefully attend to all relevant evidence of non obviousness, such as secondary consideration, in reaching a judgement of obviousness.

Question (2) Argument

The Federal Circuit, in the Stratoflex case, cited supra, does require that all evidence of secondary considerations and non-obviousness be evaluated, finding that "[i]t is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included" *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1358-59, C.A.Fed. (1983). The opinion of the Panel, however, does not reflect the secondary considerations as briefed and presented for its consideration.

The Panel's divergence from the course of analysis set forth in Stratoflex calls for an exercise of this Court's supervisory power.

Question (3)

(3) Whether the Supreme Court will address the inconsistencies in the opinions of the Federal Circuit, where the Federal Circuit found error when the District Court below failed;

(a) to give due weight to the nature of the problem to be solved and common sense as required in *Andersen Corp. v. Pella Corp.*, 300 Fed.Appx. 893, 895, C.A.Fed. (Minn. 2008) citing *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) in that the Panel did not;

(b) discuss any problem solved by the invention; make mention or discuss relevant evidence of the secondary considerations as required as set forth in *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 667, C.A.Fed. (Mo. 2000);

(c) focus on the indications of non obviousness, as required by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 14 (1966); and

(d) to explain the rationale for finding the patent obvious absent any evidence of any rational underpinning which would support the legal conclusion of obviousness, as required by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

Question (3)(a) Argument

In *Andersen* the Federal Circuit Court of Appeals reminded the lower court that the Supreme Court, in KSR, called for consideration of the problem solved and common sense, in doing obviousness analysis. The Panel did not address, or even mention, the problem solved by the use of borosilicate glass in the manufacture of sex aids, even though the problems solved, *i.e.* lack of odor retention and lubricity, were specifically stated in the patent specification, and were properly presented on appeal.

The Panel also failed to discuss, or make mention of relevant evidence of the secondary considerations, as required and set forth in *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 667, C.A.Fed. (2000). The Panel failed to mention or discuss the evidence of market success, copying by others, unexpected results, problems solved by the invention, teaching away by the prior art, or how one skilled in the art could solve a problem by using borosilicate glass, when there was no evidence or testimony that one skilled in the art was aware of any such problems.

In its discussion the Panel refers to commercial success as being a "'secondary' indicator of nonobviousness" (page 4, opinion), citing *Graham v. Deere Co.* and *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1583-84, C.A. Fed. (1997). Graham does not establish a hierarchy of importance or significance to any of the indicators of nonobviousness, but it appears that the Panel differentiates between indicators of nonobviousness and 'secondary' indicators of nonobviousness, implying that commercial success is less significant in determining nonobviousness. The Panel opinion relegates factors of

nonobviousness (commercial success) to a "secondary" nature and assigns to that set of facts a diminished evidentiary value. This position is contrary to the holding of the Graham Court. "Congress has emphasized nonobviousness as the operative test of the section" *Graham*, at 14.

Question (3)(b) Argument

Where the Graham Court did state that "such secondary considerations . . . might be utilized" Graham, at 17-18, Petitioners submit that the permissive "might" means that such evidence may exist, and be weighted, and does not allow the Court to discount existing evidence, absent any contradictory evidence.

Years before (1944) the Supreme Court addressed the issue of nonobviousness, when considering the "invention" of a metal case around a dry cell battery. The Supreme Court stated:

> Viewed after the event, the means Anthony adopted seem simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention. During a period of half a century, in which the use of flash light batteries increased enormously, and the manufacturers of flash light cells were conscious of the defects in them, no one devised a method of curing such defects. Once the method was discovered it commended itself to the public as evidenced by marked commercial success. These factors were

> entitled to weight in determining whether the improvement amounted to invention and should, in a close case, tip the scales in favor of patentability.

Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275, 276 U.S. (1944). Absent any mention of the above listed indicators of nonobviousness, it appears that the entitlement to considerations for each of the factors was overlooked by the Panel.

Question (3)(c) Argument

Graham v. Deere, *supra*, sets forth the course of investigation into the issue of obviousness, and in doing so brings the focus of the investigation on the issue of nonobviousness *Graham v. Deere*, at 14. The Panel's opinion makes passing reference to market value which is taken to be synonymous with "Market Success". However, the Panel explained away market value by alluding to "skillful marketing", absent any evidence of "skillful marketing" being included in the record before. Moreover, the Panel did not mention or discuss other considerations, such as a problem solved, copying by others, unexpected results or the acceptance by the market place, evinced by the number of web site "hits".

Question (3)(d) Argument

In KSR, cited supra, the Supreme Court rejected conclusory statements of obviousness, and, instead, required some rational underpining to support the finding of obviousness. The Panel did not describe any problems encountered by the industry or one skilled in the art, which would lead one to the discovery of the invention. Moreover, the only evidence on this point was that the industry did nothing regarding the problems identified by the patentees. Very much like *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, *supra*, in this case the industry solved any odor retention problem by selling, that is, discarding the old product and replacing it with sales of more product. The industry overcame tissue pulling by adding more lubricant. The use of borosilicate glass solved both these problems by being lubricious and resisting odor retention, as described in the specification of the Patent at issue, for which the industry, and the Defendant, offered no evidence of working to solve either problem.

CONCLUSION

The Petitioners request that the Supreme Court grant the Petition for Certiorari in that Federal Circuit Court of Appeals findings and decision has decided the issue of obviousness in a manner which has so far departed from the accepted and usual course of judicial proceedings as set forth in the case law of both the Federal Circuit Court of Appeals and the United States Supreme Court, or sanctioned such a departure by a lower court, as to call for an exercise of this Court's supervisory power. The Petitioners, therefore, respectfully request that the Petition for certiorari be granted.

Respectfully submitted,

EDWARD P. DUTKIEWICZ
P.O. Box 937
Dade City, FL 33526
(352) 467-2682

Counsel for Petitioners

APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DECIDED APRIL 24, 2009

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2008-1528, -1529

STEVEN D. RITCHIE and H. DAVID REYNARD
(as Trustee for the Harlie David Reynard, Jr. Revocable Trust),

Plaintiffs-Appellants,

v.

VAST RESOURCES, INC.
(doing business as Topco Sales),

Defendant-Cross Appellant.

Appeals from the United States District Court
for the Middle District of Florida
in case Nos. 8:05-CV-2128 and 8:06-CV-2229,
Judge Richard A. Lazzara

DECIDED: April 24, 2009

Before MICHEL, Chief Judge, BRYSON, Circuit Judge, and POSNER, Circuit Judge.*

* The Honorable Richard A. Posner, Circuit Judge, United States Court of Appeals for the Seventh Circuit, sitting by designation.

Appendix A

POSNER, Circuit Judge.

The plaintiffs brought suit for patent infringement against the defendant, and prevailed in the district court, precipitating an appeal that, among other things, challenges the patent's validity. Dissatisfied with the amount of relief the court gave them, the plaintiffs cross-appeal; but on the view we take, the only issue we shall have to consider is whether the patented invention would have been "obvious" to persons skilled in the relevant art, as that word is understood in patent law. 35 U.S.C. § 103(a).

The plaintiffs own a manufacturer, called Know Mind Enterprises, and the defendant, doing business under the name Topco Sales, is another manufacturer. Both firms produce what the parties call "sex aids" but are colloquially referred to as "sex toys." A more perspicuous term is "sexual devices," by analogy to "medical devices." The analogy lies in the fact that, like many medical devices (thermometers for example), what we are calling sexual devices are intended to be inserted into bodily orifices, albeit for a different purpose.

The devices are generally in the shape of rods of various curvatures and are made out of rubber, plastic, glass, or some combination of these materials. Until the plaintiffs began manufacturing their patented sexual devices, glass sexual devices were made out of soda-lime glass, the most common form of glass. The plaintiffs' patent (U.S. Patent No. Re 38,924, the 2005 reissue of No. 6,132,366, filed on April 1, 1999) claims a "sexual aid

Appendix A

. . . fabricated of a generally lubricous glass-based material containing an appreciable amount of an oxide of boron to render it lubricous and resistant to heat, chemicals, electricity and bacterial absorptions." Glass that contains boron oxide is called "borosilicate glass." The "silicate" is a reference to the fact that like most glass, the predominant component of borosilicate glass is silica.

By "lubricious"—a word whose primary meaning, appropriate for a sexual device, is "lecherous"—the patent means only "slippery," which is the secondary meaning of the word. The patent's use of the word in that sense is confusing, because glass is smooth rather than slippery. But what is meant is that the glass, because it contains oxide of boron, is smoother than soda-lime glass and therefore becomes slippery with less lubricant than a device made out of soda-lime glass. The patent's use of the term "appreciable amount" of oxide of boron is also troublesome, because it is vague. But apparently all that is meant is that the plaintiffs are claiming that their invention uses glass that has the amount of boron oxide usually found in borosilicate glass.

Borosilicate glass is the glass out of which Pyrex glassware was originally made, and is sometimes still made. Corning Glass Works (now Corning, Inc.), the original manufacturer of Pyrex glassware, now makes its kitchen glassware (still under the trade name Pyrex) out of tempered soda-lime glass, except in the European Union, where it continues to make it out of borosilicate glass.

That glass has the properties that the patent claims for it, and one can see how those properties (even resistance to electricity, see M. Klintschar, P. Grabuschnigg & A. Beham, *Death from Electrocution During Autoerotic Practice: Case Report and Review of the Literature*, 19 Am. J. Forensic Med. Pathology 190 (1998)) might enhance the utility of sexual devices made out of it. Nevertheless, though the plaintiffs' invention is useful (setting aside any qualms that one might have about sexual devices in general), it is not patentable if it would have been "obvious," not of course to the average person but to a person having the relevant technical skills. Given that it has commercial value, as heavily emphasized by the plaintiffs, and given that Pyrex, made originally as we said from borosilicate glass, has been sold by Corning for almost a century (and it was sold under other names beginning in 1893, when borosilicate glass was first invented), to call its use in a sexual device "obvious" may seem the triumph of hindsight over insight. Commercial value is indeed one of the indicia of nonobviousness, *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966); *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1575-76 (Fed.Cir.1984), because an invention that has commercial value is likely to come on the market very shortly after the idea constituting the invention (in this case the use of borosilicate glass in a sexual device) became obvious; if the invention did not appear so soon despite its value in the market, this is some evidence that it wasn't obvious after all. But for a variety of reasons commercial success is deemed a "secondary" indicator of nonobviousness.

E.g., *Graham v. John Deere Co.*, *supra*, 383 U.S. at 18, 86 S.Ct. 684; *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1483-84 (Fed.Cir.1997). The commercial success of a product can have many causes unrelated to patentable inventiveness; for example, the commercial success of an "invention" might be due not to the invention itself but to skillful marketing of the product embodying the invention.

Among the inventions that the law deems obvious are those modest, routine, everyday, incremental improvements of an existing product or process that confer commercial value (otherwise they would not be undertaken) but do not involve sufficient inventiveness to merit patent protection. This class of inventions is well illustrated by efforts at routine experimentation with different standard grades of a material used in a product standard in the sense that their properties, composition, and method of creation are well known, making successful results of the experimentation predictable. This is such a case.

A manufacturer might change the composition of a type of glass, such as borosilicate glass, by adding or subtracting types or amounts of the various components; and the change might not be obvious in any sense. The plaintiffs' patent, however, with its vague reference to "appreciable amounts" of oxide of boron, does not claim any variant of off-the-shelf borosilicate glass. And since that is a standard product with well-known properties—including the properties listed in the patent—to experiment with substituting borosilicate glass for ordinary glass in a sexual device was not a venture into the unknown. That is

in contrast with inventing medical devices, which require testing for safety and efficacy and approval by the Food and Drug Administration before they can be sold. Medical Device Amendments of 1976, 21 U.S.C. § 360c, *et seq.*; *see Medtronic, Inc. v. Lohr*, 518 U.S. 470, 475-77, 116 S.Ct. 2240, 135 L.Ed.2d 700 (1996).

This case thus exemplifies the Supreme Court's analysis in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S.Ct. 1727, 167 L.Ed.2d 705 (2007). "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and *a person of ordinary skill in the art would recognize that it would improve similar devices in the same way*, using the technique is obvious unless its actual application is beyond his or her skill." *Id.* at 417, 127 S.Ct. 1727 (emphasis added). (The last sentence describes our case to a tee.) There was, the Court continued, no need for the district court to "seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 418, 127 S.Ct. 1727. *See also Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1326-27 (Fed.Cir.2008).

Another case on point is *Ball Aerosol & Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 992-93 (Fed.Cir.2009): "The combination of putting feet on the

bottom of the candle holder and using the cover as a base for the candle holder was a predictable variation. . . . The combination of a cover-stand and feet on the bottom of the candle holder was obvious to try in an effort to minimize scorching, as the combination would further raise the bottom of the candle holder above the supporting surface. The resulting, and desired, decreased heat transfer between the candle holder and the supporting surface from the combination would have been entirely predictable and grounded in common sense."

And if more is required to make our point, there is the venerable case of *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 13 L.Ed. 683 (1851), cited approvingly in *KSR Int'l Co. v. Teleflex Inc.*, *supra*, 550 U.S. at 406, 415, 127 S.Ct. 1727, which denied patentability to an invention consisting of the substitution of a clay or porcelain knob for a metallic or wood knob in a doorknob (the doorknob itself, as distinct from the knob on the end of it, being an assemblage of knob, shank, and spindle). Other substitution cases in which patentability was denied on grounds of obviousness include *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535-38 (Fed.Cir. 1983); *Brunswick Corp. v. Champion Spark Plug Co.*, 689 F.2d 740, 749-50 (7th Cir.1982), and *Lyle/Carlstrom Associates, Inc. v. Manhattan Store Interiors, Inc.*, 635 F.Supp. 1371, 1381-83 (E.D.N.Y.1986), *aff'd*, 824 F.2d 977 (Fed.Cir.1987). These decisions, too, support our conclusion that the judgment must be reversed with instructions to dismiss the suit.

REVERSED

APPENDIX B — AMENDED FINAL ORDER OF THE UNITED STATES DISTRICT COURT FOR THE MIDDLE DISTRICT OF FLORIDA, TAMPA DIVISION DATED JULY 24, 2008

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
TAMPA DIVISION

CASE NO: 8:06-cv-2128-T-26TGW

STEVEN D. RITCHIE, et al.,

Plaintiff,

v.

VAST RESOURCES, INC.,

Defendant.

AMENDED FINAL ORDER

This cause came before the Court for a non-jury trial from April 21, 2008 through April 23, 2008. Before the Court are the transcripts of those proceedings (Dkts.110-112), as well as the parties' exhibits (Dkts. 107-109). The parties have also submitted post-trial briefs (Dkts. 118, 120), rebuttal briefs (Dkts. 116, 118), and proposed findings of fact and conclusions of law (Dkts. 117, 121) for the Court's consideration in rendering this final order and judgment.

Appendix B

I. BACKGROUND FACTS

This is a civil action for patent infringement in violation of the United States Patent Act of 1952, as amended, 35 U.S.C. § 271, *et seq.*, brought by Plaintiffs, Steven D. Ritchie ("Ritchie") and H. David Reynard ("Reynard"), as trustee for The Harlie David Reynard, Jr. Revocable Trust ("the Trust") under Agreement dated September 22, 1998. At issue is United States Patent No. Re 38,924 ("the '924 patent"), entitled "sex aid," which was issued by the United States Patent and Trademark Office to Plaintiffs on December 20, 2005. (Dkt. 107, Ex. 1B) The '924 patent reissued on December 20, 2005 based upon an application filed on October 16, 2002. It is a reissue of earlier patent No. 6,132,366 ("the '366 patent"), which Plaintiffs filed on April 1, 1999. (*Id.*) Ritchie and Reynard are the named inventors of the '924 patent. Reynard assigned his ownership in the '924 patent to the Trust, Ritchie did not assign his rights, and thus, the Trust and Ritchie jointly own the '924 patent. Ritchie and Reynard are the sole shareholders of Know Mind Enterprises, Inc. ("KME"). KME is a Florida corporation, with its principal place of business in St. Petersburg, Florida, that sells sex aids. KME is not a party to this lawsuit.

Defendant Vast Resources, Inc., also makes and sells sex aids, doing business as Topco Sales ("Topco"), a California corporation, with its principal place of business in Chatsworth, California. As a defense to

Appendix B

Plaintiffs' patent infringement claims, Topco asserts in its Counterclaim (Dkt. 18) that the '924 patent is invalid, pursuant to 35 U.S.C. § 101, *et seq.*

II. PLAINTIFFS' INFRINGEMENT CLAIMS

Plaintiffs allege that the following 11 Topco sex aid products infringe upon independent claims 2 or 8, or both, of the '924 patent:

Touch Me (Dkt. 109, Ex. 26):	claims 2, 8
Triple Pleaser (Dkt. 109, Ex. 28):	claims 2, 8
Heart's Delight (Dkt. 109, Ex. 30):	claims 2, 8
Spiral G (Dkt. 109, Ex. 31):	claims 2, 8
G-Spot Lover (Dkt. 109, Ex. 32):	claims 2, 8
Pink Indulgence (Dkt. 109, Ex. 33):	claims 2, 8
Pure Pleasure (Dkt. 109, Ex. 35):	claim 8
Spine (Dkt. 109, Ex. 36):	claims 2, 8
Petite Plug (Dkt. 107, Ex. 7H):	claim 8
Crystal Plug (Dkt. 109, Ex. 27):	claim 8
Confetti Curve (Dkt. 109, Ex. 29):	claims 2, 8

Appendix B

Plaintiffs also allege that the following devices infringe one or more dependent claims of the '924 patent.

Touch Me (Dkt. 109, Ex. 26):	claims 3, 11
Triple Pleaser (Dkt. 109, Ex. 28):	claims 6, 9, 11
Heart's Delight (Dkt. 109, Ex. 30):	claims 4, 11
G-Spot Lover (Dkt. 109, Ex. 32):	claims 3, 11
Pink Indulgence (Dkt. 109, Ex. 33):	claims 3, 11
Confetti Curve (Dkt. 109, Ex. 29):	claims 6, 9, 11

III. THE PATENT CLAIMS AT ISSUE

Independent claims 2 and 8 of the '924 patent read as follows:

> 2. A sexual aid comprising:
>
> a solid rod having a length with a first end and a second end constituting a gripping area; and
>
> a spherical enlargement integrally formed in the first end of the rod, the rod and enlargement being fabricated of a generally lubricious glass-based material containing an appreciable amount of an oxide of boron to

render it lubricious and resistant to heat, chemicals, electricity and bacterial absorption, with the rod having a bend within its length between the gripping area and the first end having the spherical enlargement.

. . .

8. A method of using a sex aid to increase stimulation during sex acts comprising the steps of:

providing a rod having a length with a first end and a second end constituting a gripping area; and

providing an enlargement integrally formed in the first end of the rod, the rod and enlargement being fabricated of a generally lubricious glass-based material containing an appreciable amount of an oxide of boron to render it lubricious and resistant to heat, chemicals, electricity and bacterial absorption, and stimulating a user through the provided sex aid during anal and vaginal stimulation.

(Dkt. 107, Ex. 1B, Cols. 5-6.)

Dependent claims 3, 4, 6, 9, and 11 provide as follows:

3. The aid as set forth in claim 2 wherein there are plural enlargements.

4. The aid as set forth in claim 2 wherein the gripping area is a loop.

. . .

6. A sexual aid kit comprising the sexual aid as set forth in claim 2 and further including a water based lubricant used with the aid.

. . .

9. The method as set forth in claim 8 and further including the step of utilizing the sex aid with a water based lubricant.

. . .

11. The aid as set forth in claim 2 wherein the bend is an obtuse angle. (*Id.*)

IV. CLAIMS CONSTRUCTION

On January 11, 2008, this Court held a *Markman*[1] hearing in order to construe the above claims. As a matter of law, this Court determined that:

(1) "sexual aid" means "something used to enhance a sexual experience" (*see* Markman Hearing Transcript, Dkt. 71, 13:3-8);

---

1. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

(2) "gripping area" means "area used for holding onto something" (*see id.* at 19:3);

(3) "spherical" means "rounded, like a globe or a ball" (*see id.* at 58:5);

(4) "enlargement" means "a region that is larger than the immediately adjacent area" (*see id.* at 31:5);

(5) "integrally formed" means "generally continuous with, part of" (*see id.* at 31:8);

(6) "at the end of the rod" means "in the vicinity of the end" (*see id.* at 34:5-37:10);

(7) "bend" means a "defined angle" (*see id.* at 67:14);

(8) "plural enlargements" means "at least two enlargements" (*see id.* at 67:18);

(9) "loop" means "generally or nearly closed form" (*see id.* at 67:20);

(10) "obtuse angle" means "an angle greater than 90 degrees" (*see id.* at 87:22);

(11) "rod" and "solid rod" means "generally straight with an elongated appearance" (*see id.* at 80:13);

(12) "lubricious" means "slippery" (*see id.* at 58:3);

(13) "appreciable amount" is an amount "able to be measured or determined" (*see id.* at 49-53);

(14) "method" means "requiring one or more persons using the sex aid during a sex act" (*see id.* at 75:24);

(15) "providing" means "an element or thing to be carried out" (*see id.* at 80:9);

(16) "kit" means "pre-packaged;" (*see id.* at 73:20-74:21);

(17) "and" in the phrase "vaginal and anal stimulation" means "as well as," but does not mean "simultaneously" (*see id.* at 86:15); and

(18) "increased stimulation" means that the "method requires a stimulation during a sex act greater than a person normally would have without the sex aid." (*See id.* at 76-77.)

V. DISCUSSION

A. Patent Invalidity and Unenforceability

Pursuant to 35 U.S.C. § 282, a patent is presumed to be valid. *See Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809 (1986). In its Counterclaim, Topco asserts patent invalidity as its defense to Plaintiffs' claims of patent infringement and it has the burden of proving each invalidity defense with clear and convincing evidence. *See Pharmastem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007) (clear and

convincing evidence established obviousness). Topco raises the following grounds of patent invalidity and unenforceability:

1. Indefiniteness

Patent claims must "particularly point [] out and distinctly claim [] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2. This requirement serves to ensure that the patentee adequately notifies the public of the scope of the invention. *See Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005). Indefiniteness is a question of law. *See Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1378 (Fed. Cir. 1999). Compliance with the claim definiteness requirement occurs where a person skilled in the art "would understand the bounds of the claim when read in light of the specification . . . [and] reasonably apprise those skilled in the art of the scope of the invention." *Solomon v. Kimberly-Clark Co.*, 216 F.3d 1372, 1378 (Fed. Cir. 2000). Definiteness does not demand "absolute clarity." *Datamize*, 417 F.3d at 1347. Only those claims that are "not amenable to construction" or "insolubly ambiguous" are indefinite. *Id.* The fact that the claim element contains words of degree such as "substantially," "about," or "closely approximate" does not necessarily render the claim indefinite. *See Verve LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120 (Fed. Cir. 2002).

Appendix B

Topco argues that the patent should be declared invalid because the terms "appreciable amount," (claims 2 and 8), "lubricious" (claims 1, 2 and 8) and "increase stimulation" (claim 8) are indefinite for failing to provide a clear-cut indication of the scope of subject matter embraced by the claim. However, the Court has construed "appreciable amount" to mean "an amount that is measurable" and further, the claims state that the appreciable amount is the amount required to provide specific properties. One skilled in the art would certainly realize that the properties stated in the claims language are the measure of the amount of oxide of boron needed. Plaintiffs' expert[2], Dr. Elliott Stern ("Stern"), who holds a Ph.D. in mechanical engineering, testified that a half percent of oxide of boron would have minimal effects on the physical properties of glass. (Trial Transcript, Volume 3, Dkt. 112, 71:18-19.)[3] Thus, if the amount does not produce those properties and it is not measurable, then it is not covered within the scope of the claim. Absolute clarity is not a requirement.

As to the term "lubricious," Topco asserts that the term is indefinite because "lubriciousness" is obviously dependent on the user's perception and it will vary among users. Notwithstanding, the Court has construed the term "lubricious" to mean "slippery." As Plaintiffs

---

2. It should be noted at the outset that Topco did not call any of its own witnesses to testify at trial.

3. Cites to the trial transcript will hereafter be signaled by "TT," with the volume number being signaled by "V," followed by the docket, page and line numbers.

point out, the claims language does not claim that oxide of boron glass is more slippery than any other glass, only that it is "lubricious." Stern testified as to the lubricity of oxide of boron by stating that it is has a lower coefficient of friction. (*Id.* at 81:2-16.) David Sager, the glass blower hired by Plaintiffs to develop the prototype device, stated that all glass is slippery. (TT, V2, Dkt. 111, 21:20.) Reynard described using a borosilicate glass sex aid vaginally and rectally, and his testimony was that it was "very slippery." (TT, V1, Dkt. 110, 51:16.) Topco failed to provide any evidence to the contrary or call any rebuttal witnesses to testify. Topco's third issue as to the definiteness of the patent is without merit inasmuch as it is common sense that slipping an accused device into a rectum or a vagina would certainly "increase stimulation" or "cause a level of stimulation greater than just before the insertion."

2. Lack of Enablement

Enablement requires that "one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation." *AK Steel Corp. v. Sollac,* 344 F.3d 1234, 1244 (Fed. Cir. 2003). To satisfy the enablement requirement, the specification must set forth the "manner and process of making and using [the invention] in such full, clear, and concise exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." 35 U.S.C. § 112, ¶ 1. The purpose of the enablement provision is to ensure that "the public knowledge is enriched by the

patent specification to a degree at least commensurate with the scope of the claims. The scope of the claims must be less than or equal to the scope of the enablement." *National Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1195-96 (Fed. Cir. 1999). Enablement is a question of law. *See In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir. 1991). The Federal Circuit has noted, "[t]hat some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is 'undue.' " *Id.* at 495. In determining what constitutes undue experimentation, courts should apply a reasonableness standard, taking into account: (1) the quantity of experimentation necessary; (2) the amount of direction or guidance presented; (3) the presence or absence of working examples; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability or unpredictability of the art; and (8) the breadth of the claims. *See In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

The '924 patent claims a sex aid "fabricated of a generally lubricious glass-based material containing an appreciable amount of an oxide of boron to render it lubricious and resistant to heat, chemicals, electricity and bacterial absorption." (Dkt. 107, Ex. 1B, Col. 5, 6.) Topco maintains that the '924 patent fails to enable the terms "glass-based material containing . . ." because adding an oxide of boron does not render glass slippery or resistant to heat and electricity.

Appendix B

The Court observes that the '924 patent actually describes a solid cylindrical glass rod to which various other features are added. (Dkt. 107, Ex. 1B, Col. 3, l. 35.) Plaintiffs do not claim to have invented the glass rod, but rather they have included the terms in question in the '924 patent in order to specify that the starting point for the invention is not a rod composed of conventional or soda lime glass. Moving on, Stern testified that oxide of boron glass was commercially called borosilicate glass. (TT, V3, Dkt. 112, 11:7-12.) Stern also testified as to the lubricity of oxide of boron by stating that it has a lower coefficient of friction. (*Id.* at 81:2-16.) Topco did not present any of its own evidence on the issue of enablement. The seminal issue in an enablement analysis is what one skilled in the art, with some experimentation being acceptable, would be able to do with the patent disclosure. Sager testified that he had no problem making the device. (TT, V2, Dkt. 111, 17:9-25.) Furthermore, because the properties of resistance to heat, chemicals, electricity and bacterial absorption are inherent in borosilicate glass, or glass having an appreciable amount of oxide of boron, the use of such glass to make the device necessarily enables all the elements of the claims. Plaintiffs are not required to specify on a molecular level just how these are accomplished in order to satisfy enablement, as it seems Topco suggests. The Court finds that the '924 patent is sufficiently enabled.

Appendix B

3. Obviousness

Patent claims are presumed to be non-obvious. *See Kahn v. General Motors Corp.*, 135 F.3d 1472, 1480 (Fed. Cir. 1998). However, the Supreme Court has held that a "patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men. *Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152 (1950). Topco contends that the '924 patent is invalid because the combination of borosilicate glass, which was well known in the art for the last 100 years, with a sex aid, to form the present device, yields expected results and is obvious to one skilled in the art.

In *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), the Supreme Court set forth the following analysis required to determine obviousness:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.
>
> . . . .
>
> Such considerations as commercial success, long felt but unsolved needs, failure of others,

> etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

The Court must consider the entire prior art patent, and not just one aspect of it. *See In re Gurley,* 27 F.3d 551 (Fed. Cir. 1994)). In considering the totality of a reference's teachings, the court may consider whether the prior art "teaches away" from the invention at issue, to wit, whether the reference suggests that the developments flowing from its disclosures are unlikely to produce the objective of the applicant's invention. *Id.* at 553. For purposes of this case, the level of ordinary skill in the art is a person who designs sex aids and knows borosilicate glass properties. (TT, V3, Dkt. 112, 98:6-11; 190:8-11.)

Topco urges that prior art teaches all of the claim elements and that the patent examiner overlooked the most important prior art patent, Patent No. 5,835,362 ("the Jacobs Patent"), which discloses an inerrable sex aid that can be made of glass and teaches the shapes that the '924 Patent claims. (Dkt. 108, Ex. 526). Topco urges that the only difference between the Jacobs patent, or any prior art for that matter, and the invention claimed in claims 2 and 8 is the use of borosilicate glass and the patent's defined angles and spherical enlargements. However, the evidence shows that the

'924 patent examiner reviewed the Jacobs Patent, as well as the following 12 other patents:

Patent No. 870,087	("the Dickens Patent")
Patent No. 1,944,926	("the Colbeth Patent")
Patent No. 2,700,109	("the Argabrite Patent")
Patent No. 3,726,141	("the Bremer Patent")
Patent No. 3,968,690	("the Blouin Patent")
Patent No. 3,996,930	("the Sekulich Patent")
Patent No. 4,390,555	("the Levinson Patent")
Patent No. D272,649	("the Bloch Patent")
Patent No. 5,114,495	("the Mainz Patent")
Patent No. 5,387,179	("the Crivellaro Patent")
Patent No. 5,421,547	("the Phillips Patent")
Patent No. 5,690,603	("the Kain Patent")

Plaintiffs' counsel argued the distinctions between the prior art and '924 device and the examiner was ultimately convinced, finding that the prior art does not teach or fairly suggest a solid glass based rod including the structure as claimed.

Topco now argues that because all of the elements in Plaintiffs' device were present in some form in the prior art, Plaintiffs' final product was predictable. The Court disagrees. The Jacobs Patent teaches a sex aid that may be made of a "class of materials that consists of wood, metal, plastic, rubber, wax, glass, and composite materials. (*See* Dkt. 108, Ex. 526.) It also teaches a molding process, which takes days to cure, to make all embodiments, rather than the use of borosilicate glass. (*See id.*) Although the Dickens Patent teaches a glass

pestle, it specifically teaches a straight shaft, whereas the structure claimed by Plaintiffs' device requires a bend or handle. (*See id.* at Ex. 536.) Also, Dickens does not teach any of the properties of borosilicate glass. (*See id.*) The Bloch Patent teaches sex aids with multiple spherical enlargements along a rod. (*See id.* at Exs. 567, 569.) The specifications do not disclose the surface conditions, whether smooth or rough, or heat, electricity, and chemical resistant, which causes the Court to make many assumptions about the device, all of which are unsupported by evidence or testimony. (*See id.*) The Kain Patent teaches an angled sex aid made of a rigid material that could be used for simultaneous vaginal and anal insertion for two persons. (*See id.* at Dkt. 564.) Kain teaches both smooth and slippery sex aids. (*See id.*) The Kain patent also suggests that sex aids may be constructed of "rather rigid material" or "more compressible or resilient material" depending on preferences. (*See id.*) These materials teach away from Plaintiffs' invention and render the device inappropriate for consideration as prior art.

Topco offers up several other patents that it feels should have been considered as prior art during the '924 patent examination. However, they simply do not lend any support to Topco's obviousness argument. The Stoy Patent, U.S. Patent No. 4,563,182, teaches freezing an anal insert with an enlargement to make it cold, hard, and slippery. (*See id.* at Ex. 588.) The Hawtof Patent, U.S. Patent No. 2,562,714, teaches a hollow tube that is preferably made of borosilicate glass and preferably contains a magnetic insert. (*See id.* at Ex. 553.) Thus,

the patent teaches away from a solid rod of borosilicate glass. The Radford Patent, U.S. Patent No. 2,591,375, teaches a device that is a cylindrical Pyrex glass tube that can be submerged in a beverage for cooling and can function as a stirrer. (*See id.* at Ex. 554.) Radford and the invention claimed in claims 2 and 8 differ in that Radford is a hollow tube to hold refrigerant. Because Radford teaches a hollow construct, it teaches away from the solid glass rod used in Plaintiffs' invention and, thus, should not be considered pertinent prior art.

The Ayres Patent, U.S. Patent No. 3,481,375, teaches borosilicate glass for thermometers to be inserted into the rectum or other bodily orifice. (*See id.* at Ex. 555.) The prior art thermometer is hollow to perform its regular function and, thus, it teaches away from solid and should not be considered prior art. The Beall Patent, U.S. Patent No. 4,118,237, teaches a glass and ceramic combination for producing various articles. (*See id.* at 561.) And, while no testimony was offered to assist the Court in understanding the technical description contained in the patent, it is clear that the patented material was tested against Pyrex, a known borosilicate glass, as a comparison. (*Id.* at Col. 4.) Thus, the patentee thought that borosilicate glass was different from that for which he claimed protection.

Topco also relies on Reynard's admission to having used a glass martini stirrer as a sex aid with his girlfriend some 30 years before Ritchie and Reynard's alleged invention of the device in the '924 Patent. (TT, V3, Dkt. 112, 203:9-13.) Reynard admits that he purchased the

stirrer from an antique shop. (*Id.* at 161:4-18). However, he testified that he did not know if the stirrer was made of glass or possibly some other material such as acrylic. (*Id.*) Topco offers no evidence to show otherwise and, thus, the stirrer in question should not be considered pertinent prior art.

Further, Topco challenges the examiner's failure to cite any prior art books mentioning glass sex aids, despite the fact that glass sex aids were used 2,000 years ago and that museums have glass phalluses from the Roman Empire. Topco points out the Kinsey Institute Library has a glass phallus from 1970. However, the patent examiner did review an internet webpage for a business known as "TheOriginalGlassSexAid.com," which touted the use of Pyrex to form sex aids since 1998. (*See* Dkt. 107, Ex. 1B, 1.) Ultimately, the examiner concluded that while "[t]he prior art discloses a large number of sex aids of known designs and configurations . . . the sex aid according to the present invention substantially departs from the conventional concepts and designs of the prior art, and in doing so provides an apparatus primarily developed for the purpose of increasing stimulation during sex acts." (*See id.* at Ex. 113, Col. 1, ¶2.) The examiner went on to find that "it can be appreciated that there exists a continuing need for a new and improved sex aid which can be used for increasing stimulation during sex acts. In this regard, the present invention substantially fulfills this need. (*See id.*)

While familiar items may have obvious uses beyond their primary purposes, the Supreme Court has cautioned against the use of the pat hindsight-based solution that Topco suggests in this case. Specifically, the Court has held that:

> . . . patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR Intern. Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1741 (2007). It is clear to the Court that none of the prior art, including the glass phalluses mentioned in art books and found in museums, teaches a solid rod with one or more spherical enlargements and a handle all fabricated of a generally lubricious glass-based material containing an appreciable amount of an oxide of boron to render it lubricious and resistant to heat, chemicals, and bacterial absorption. (*See* Dkt. 108, Exs. 570, 571, 572, 573.)

Appendix B

Borosilicate glass was invented in 1893 and has been used for a multitude of purposes, but Plaintiffs make a strong argument that no one before them had made the link between the use of such material and the manufacture of sex aids. Plaintiffs assert that it was only after their product was featured on an HBO television program called "Real Sex, Episode 27" that the product caught on and other similar sex aids made of borosilicate glass began to show up in the marketplace, including those manufactured by Topco. (TT, V1, Dkt. 110, 96:9-17; 99:7-100:15.) Topco offers no evidence to counter Plaintiffs' assertion. As Plaintiffs point out, a Google search using the words "glass dildo" now creates more than 300,000 references. (*Id.* at 60:3.) Plaintiffs' argument is only bolstered by the evidence of its own commercial success and Defendants' records of sales of these particular sex aids. (Dkt. 107, Exs. 4, 22.) Plaintiffs' use of borosilicate glass in its invention gave several properties to sex aids that were not present before, but for which there was, as we now know, a strong demand. Plaintiffs' introduction of those properties in their invention appears to have been an improvement in the art. Stern even concluded that while "all those properties were well understood at the time, . . . I did not find in my analysis that one of ordinary skill in the art recognized borosilicate glass as the means to deliver desirable features for a sex aid use." (TT, V3, Dkt. 112, 101:2-6.) Reynard testified that he saw the various shortcomings with products in the marketplace at the time of his invention and that the industry was not concerned with the problems inherent in the existing devices. (TT, VI, Dkt. 110, 135:6-17.)

Appendix B

To rely on commercial success to refute evidence of obviousness, a plaintiff must prove that any commercial success flows from the merits of the claimed invention, i.e., a nexus between the claimed invention and commercial success. *See Sjaelland v. Musland*, 847 F.2d 1573, 1582 (Fed. Cir. 1988). Alleged commercial success must be "due to the nature of the claimed invention, as opposed to other economic and commercial factors." *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1027 (Fed. Cir. 1985). "A *prima facie* case of nexus for commercial success is generally made out when the patentee shows both that there is commercial success, and that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent." *In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). Topco urges the Court to disregard as waived by Plaintiffs any evidence of commercial success to counter obviousness. In light of the evidence and other submissions from the parties, the Court disagrees with Topco.

A patent's commercial success and the failure of competitors to develop equally successful inventions are important factors weighing in favor of the validity of patent. *See Panduit*, 475 U.S. at 810. Topco has not produced any evidence to demonstrate that the adult sex toy industry was considering the problems with sterilization, odor retention, surface smoothness, lubricity, or resistance to heat, chemicals, electricity, and bacterial absorption or was even aware of such problems even existed. Ritchie, on the other hand, testified that he had identified the disadvantages of the existing prior

art and that the use of borosilicate glass to make sexual aids addresses and solves these problems. Reynard testified that at one time he counted 33 manufacturers making borosilicate glass toys since the time of the '924 patent. (TT, VI, Dkt. 110, 166:23.) That number has not been disputed. In opening remarks, Topco conceded that it had sold $700,000 worth of borosilicate glass product since the onset of this action. (*Id.* at 19:12.) Plaintiffs testified that they were compelled to lower their prices in order to compete with the products offered by others, including Topco. (*Id.* at 106:8.)

Evidence that those of ordinary skill could not solve the problem that the inventors solved may be evidence of non-obviousness. However, a showing that the inventors met a long-felt need requires evidence that those of ordinary skill recognized a persistent need. *See Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381 (Fed. Cir. 1983). Plaintiffs did not introduce any evidence of this nature to counter Topco's obviousness arguments because one of their primary arguments throughout this case has been that while the tremendous commercial success of borosilicate glass sex aids after the airing of the HBO program reflects a strong demand for such devices, no one before Plaintiffs even recognized the need for the invention. For similar reasons, Plaintiffs have not sought to introduce evidence that others tried and failed to produce a non-infringing device in order to compete with their invention. The evidence in this case shows that no borosilicate glass sex toys appeared in the market place prior to Plaintiffs' invention and that the adult sex toy

industry was not even considering remedying the problems with sterilization, odor retention, surface smoothness, lubricity, or resistance to heat, chemicals, electricity, and bacterial absorption. As Plaintiffs put it, failure of sex aids was the state of the art because it was perceived to equate to more sales and profits. However, the fact that the idea for glass sex aids is now being widely copied, producing a marketplace full of competitors, only seems to bolster Plaintiffs' argument that their invention was not obvious. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 732 (2002); *Troy Co. v. Products Research Co.*, 339 F.2d 364, 367 (9th Cir. 1964). In light of all the foregoing, the Court finds that patent claims are not invalid for obviousness.

4. New Matter Violation

Topco argues that claims 6 and 7 of the '924 patent are invalid because the inclusion of the kit concept is new matter. Pursuant to 35 U.S.C. § 132, "no amendment shall introduce new matter into the disclosure of the invention." Unless material added by amendment was inherently contained in the original application, the patent is invalid for introducing new matter. *See Schering Corp. v. Amgen Inc.*, 222 F.3d 1347, 1352 (Fed. Cir. 2000). When an applicant introduces additional disclosure into a patent application, the original disclosure of the application must "reasonably convey to the artisan that the inventor had possession at that time of the later claimed subject matter." *Vas-Cath, Inc.*

v. Mahurkar, 935 F.2d 1555, 1563 (Fed. Cir. 1991). Otherwise, the patent is invalid for adding new matter. *Id.*

Claims 6 and 7 claim, "a sexual aid kit" of the sex aid and a lubricant. A "kit" is "a pre-packaged container . . . that contains a sexual aid with one or more objects." (*See* Dkt. 71, 72:24-73:2.) The first mention of "kit" in the '924 patent came in plaintiffs' December 17, 2004, amendment. (Dkt. 108, Ex. 546.) While the specification contained no mention of a "kit," it did describe the use of the borosilicate glass sex aid along with a lubricant, in the same location, and in the same use. (Dkt. 107, Ex. 1B.) The patent examiner noted that:

> The claims need to be written as kit claims. The examiner believes that the lubricant claimed is not provided on the sex aid or as part of the sex aid but merely an additional element used in conjunction with the sex aid further, new lubricant must be provided each time the device is used. Therefore the claims must be set forth as a kit claim.

(Dkt. 108, Ex. 590.) Plaintiffs responded by making the following revisions:

> 10. (Currently Amended) *A sexual* aid *kit comprising the sexual aid* as set forth in Claim 2 and further including a water based lubricant used with the aid.

(*Id.* at Ex. 546.) The Court finds that a "kit" is simply a way of clarifying the description of the device as claimed before the use of the word "kit" and, as such, the inclusion of "kit" in claims 6 and 7 does not add any new matter or teaching.

5. Best Mode Violation

Topco urges that the '924 patent is invalid for failing to disclose using borosilicate glass and beginning fabrication with a solid borosilicate glass rod. A patent must "set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. § 112, ¶ 1. The two-part test for a proper "best mode" analysis is: (1) whether the inventors "knew of a mode of practicing [their] claimed invention that [they] considered to be better than any other . . . ;" and (2) whether the inventors' disclosure in the patent reflected what they knew–that is, whether their "disclosure [is] adequate to enable one skilled in the art to practice the best mode . . ." *Automotive Prods. plc v. Tilton Eng'g, Inc.*, 1994 WL 227967, at *3 (C.D. Cal. Feb. 28, 1994). Invalidity for violation of the best mode requires intentional concealment of a better mode than the patent discloses.

Topco argues that Plaintiffs knew, before they filed their patent application, to begin fabricating the device with available rods of borosilicate glass, but yet, the '924 patent does not use the term borosilicate glass and describes nothing about the manufacturing process. However, Plaintiffs do not claim to invent the process of

making the glass rod. The patent actually describes a solid glass rod to which various other features are added. (Dkt. 107, Ex. 1B, Col. 3, l. 35.) David Sager, the glass blower hired by Plaintiffs to produce the invention prototype, testified that he had no problem making the device following the simple diagrams that were provided to him by Plaintiffs. (TT, V2, Dkt. 111, 17:9-25.) Topco failed to present any evidence to the contrary. Thus, the Court finds that one skilled in a related field could make Plaintiffs' invention following their disclosure and that the '924 patent is not invalid for violating the best mode.

6. Misjoinder of Inventors

35 U.S.C. § 102(f) requires a patent applicant to name the correct inventor or inventors as a condition of patentability. Failure to name them renders a patent invalid. *See Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350 (Fed. Cir. 1998). Topco asserts that David Hack ("Hack") and Charles Sidwell ("Sidwell") are joint inventors of the claimed invention and that Plaintiffs' failure to name them as such renders the '924 patent invalid. Topco points out that it was Hack or Sager, and not Plaintiffs, who knew how to make sex aids from borosilicate glass rods. (*See* TT, V3, Dkt. 112, 129:13-15.) Topco also argues that Plaintiffs' attorney, Sidwell, drafted the patent application and came up with the language that an appreciable amount of an oxide of boron renders the glass lubricious. (*See id.* at 125:23-126:7.) However, Section 102(f) provides that "[a] person shall be entitled to a patent unless he did not himself invent the subject

matter sought to be patented . . ." Section 102(f) bars issuance of a valid patent to a person or persons who derive the conception of the invention from any other source or person. 1 Donald S. Chisum, *Chisum on Patents* § 2.03, at 2-40 & nn.1-2 (2000). Topco fails to prove by clear and convincing evidence that the '924 patent claims are invalid under Section 102(f). Plaintiffs' trial testimony was that they disclosed their conception of the invention to Sidwell, who in turn used what he felt was the best language available to describe the invention. (TT, V3, Dkt. 112, 125:23-126:7.) Topco fails to present any clear and convincing evidence to the contrary. Topco could have deposed Sidwell or called him as a trial witness, but it chose not to do so. Sager testified that he followed the drawings made by Plaintiffs, which were sufficient for him to construct the device. (TT, V2, Dkt. 111, 18:12-19:12.) The Court agrees with Plaintiffs that when they reduced their devices to drawings, and provided the information regarding the materials to be used in making the devices to Sager and Sidwell, the invention was reduced to completeness.

7. Inequitable Conduct

Topco alleges that Plaintiffs engaged in inequitable conduct in the prosecution of their patent before the patent examiner. "[A] patent may be valid and yet be rendered unenforceable for . . . inequitable conduct." *Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1214 (Fed. Cir. 1987). In order to prevail in this defense, a defendant must establish by clear and convincing evidence that the patentees: (1) either made an

affirmative misrepresentation of material fact or failed to disclose material information; and (2) intended to deceive the United States Patent and Trademark Office. *See Cargill, Inc. v. Canbra Foods, Ltd.*, 476 F.3d 1359, 1363 (Fed. Cir. 2007). Topco has the burden to prove inequitable conduct with clear and convincing evidence. *See Intirtool, Ltd. v. Texar Corp.*, 369 F.3d 1289, 1296 (Fed. Cir. 2004). (Fed. Cir. 2000).

Topco fails to meet its burden. Topco asserts that Ritchie, Reynard, and their patent attorneys breached their duty to act candidly with the Patent and Trademark Office through the following three acts: First, Topco argues that the attorney who wrote the patent made up the fact that the appreciable amount of oxide of boron made the glass sex aid lubricious, and resistant to heat, chemicals, electricity and bacterial absorption. Second, Topco argues that Reynard knew, while the patent was pending, that glass sex aids were 2,000 years old. Third, Topco argues that Reynard's admitted sexual use of a glass martini stirrer with his girlfriend some 30 years ago should have been disclosed. Topco maintains that Reynard knew that borosilicate glass by itself was not slippery, but yet he and his attorney intentionally misled the examiner, who in turn allowed the patent because of the false advantages of Plaintiffs' patent claims. Topco also urges that the patent examiner did not apply any prior art glass sex aids to the pending claims and that had he appreciated that glass sex aids were old, he would have had stronger grounds to conclude the obviousness of substituting borosilicate glass for conventional glass in sex aids.

However, Topco fails to provide the Court with any clear and convincing evidence of any intent to deceive on the part of Plaintiffs. Reynard testified that he did not intend to conceal any information from the patent office. (TT, V3, Dkt. 112, 196:18.) Topco failed to present any evidence to the contrary.

As to the first act, Reynard's trial testimony was that Plaintiffs disclosed their invention to their attorney, Sidwell, who in turn used the language available to describe the invention. (TT, V3, Dkt. 112, 125:23-126:7.) Reynard testified that at that time he believed that lubricious meant "smooth or slippery," pursuant to the dictionary definition. (*Id.* at 126:22-23.) He also testified that dry glass could be slippery, depending on the interacting surface. (TT, V1, Dkt. 110, 136:15-25; V3, Dkt. 112, 130:1-24.) It is clear to this Court that in drafting the patent, Sidwell simply described the glass in terms of what gives it its properties and the amount of an oxide of boron that caused the glass to have the properties that Plaintiffs suggested. Nowhere in the patent do Plaintiffs claim that an oxide of boron makes glass more lubricious than soda lime glass.

With regard to the second and third acts, Reynard testified that he had heard from others that glass sex aids had been made 2,000 years ago, but that he had no first hand knowledge of the matter. (TT, V3, Dkt. 112, 157:2-7.) Topco failed to prove otherwise. Furthermore, the Court is not convinced that the presence of a glass sex object in ancient Rome, without publication, amounts to prior art. As for the martini stirrer, Reynard testified

that he had forgotten all about his use of the martini stirrer as a sex aid until this litigation arose. (*Id.* at 160:11.)

B. Patent Infringement

Plaintiffs assert that 11 Topco devices infringe one or more of the following claims 2, 3, 4, 6, 8, 9 and 11 of the '924 patent. As previously discussed, claims 2 and 8 are independent claims, whereas claims 3, 4, 6, 9, and 11 are dependent claims. Plaintiffs maintain that Topco's infringement of claim 8 is indirect. Plaintiffs do not assert that claims 1, 5, 7 and 10 have been infringed. Topco stipulated that all of the accused devices are made of borosilicate glass. (TT, V3, Dkt. 112, 191:22-23.)

The patent holder bears the burden of proving infringement by a preponderance of the evidence. *See Centricut, LLC v. Esab Group. Inc.*, 390 F.3d 1361, 1367 (Fed. Cir. 2004). Circumstantial evidence is sufficient. *See Moleculon Research Corp. v. CBS. Inc.*, 793 F.2d 1261, 1272 (Fed. Cir. 1986). The Patent Act addresses infringement in section 271, which establishes liability based on either of the following acts: (1) direct infringement; or (2) indirect infringement. 35 U.S.C. § 271. A person is liable for direct infringement if he "without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefore . . ." 35 U.S.C. § 271(a). An infringer's intent is immaterial to the direct

infringement analysis.[4] *Id.* Indirect infringement, on the other hand, involves situations in which a person assists or supports another's direct infringement of a patented invention. *See Dynacore Holding Corp. v. U.S. Philips Corp.*, 363 F.3d 1263, 1272 (Fed. Cir. 2004).

There exist two types of indirect infringement for which an individual may be liable: (1) inducement; and (2) contributory infringement. 35 U.S.C. §§ 271(b), (c). Only claims of direct infringement and inducement are raised in the instant case. A finding of inducement requires that a person "actively and knowingly aid[s] and abet[s] another's direct infringement." *Water Techs. Corp. v. Calto. Ltd.*, 850 F.2d 660, 668 (Fed. Cir. 1988). Accordingly, the inducer must have actual or

4. A separate cause of action does exist, however, for willful infringement. "[T]o establish willful infringement, a patentee must show by clear and convincing evidence that the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent." *In re Seagate Tech., LLC*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (*en banc*). "[T]he patentee must also demonstrate that this objectively-defined risk (determined by the record developed in the infringement proceeding) was either known or so obvious that it should have been known to the accused infringer." *Id.* Mere knowledge of the patent does not establish willful infringement. *See Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1351-52 (Fed. Cir. 2000). With a showing of willful infringement, a plaintiff may be entitled to enhanced damages. Plaintiffs in the case at bar have not presented any evidence of willful infringement and, therefore, the Court previously ruled that if Topco was found to have infringed on the '924 patent claims, it was not "willful." (*See* TT, V3, Dkt. 112, 119:2-8.)

constructive knowledge of the patent. *See Insituform Techs., Inc. v. Cat Contracting. Inc.*, 161 F.3d 688, 695 (Fed. Cir. 1998). Proof of intent to induce infringement may be shown by direct or circumstantial evidence. *See Water Techs, Corp. v. Calto, Ltd.*, 850 F.2d 660, 668 (Fed. Cir. 1988).

An infringement analysis involves a two-step process: (1) determination of the scope and meaning of the patent claims in dispute and (2) comparison of the properly construed claims with the accused product or process. *See Cybor Corp. v. FAS Techs.. Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998) (*en banc*). For Plaintiffs to successfully prove infringement, they must show that each accused device or process has every element of a particular claim. *See Laitram Corp. v. Rexnord*, 939 F.2d 1533, 1539 (Fed. Cir. 1991) (holding that one missing element avoids infringement).

1. Comparison of the Patent Claims at Issue to the Accused Devices

The Court has conducted an independent comparison of the accused devices (Dkt. 109, Exs. 26, 27, 28, 29, 30, 31, 32, 33, 35, 36, 7H) with the '924 patent's construed claims. The Court has also carefully considered all of the evidence presented in this case; to include the infringement testimony of Reynard and Stern, as well as Stern's expert report (Dkt. 107, Ex.

11).[5] Having done so, the Court holds that the evidence supports a finding of infringement of some, but not all, of the claims of the '924 patent asserted by Plaintiffs. The Court finds as follows:

Topco's Touch Me infringes upon claim 8 in that it provides a solid rod having a length with a first end and a second end constituting a gripping area. (*See* Dkt. 109, Ex. 26; *see also* TT, V3, Dkt. 112, 24:10-26:5.) An enlargement is integrally formed with the first end, and both the enlargement and the rod are made of generally lubricious glass-based material[6] that is resistant to heat,

---

5. The Court acknowledges that it is not required to believe Stern's opinion that any devices infringe. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 842 F.2d 1275, 1280 (Fed. Cir. 1988) (holding that the factfinder not obligated to accept conclusionary infringement opinion of expert.). The Court also acknowledges that both Stern and Reynard admitted that they had not read the transcript of the *Markman* hearing in order to learn how the language of the patent claims is construed. (*See* TT, V1, Dkt. 110, 174:25-175-7; TT, V3, Dkt. 112, 20:7-10.)

6. As to lubricity, Reynard testified that his experience with using a borosilicate glass sex aid in such application was "very slippery." (TT, VI, Dkt. 110, 51:16.) On the subject of lubricity, Stern later testified as follows:

> I don't know if the exact mechanism of why oxides of boron influence these properties of lubricity are well understood in glass science, but to my recollection, it is indicated that borosilicate glass, and adding an oxide of boron, have beneficial influence on reduced coefficient of friction along

(Cont'd)

chemicals, electricity, and bacterial absorption. (*See id.*) The device comes with a package of water-based lubricant and provides a means for stimulating the user through the use of the sex aid for anal as well as vaginal stimulation. (*See id.*) The Court finds further evidence of infringement in the product's packaging, which describes "frictionless sensations," "a curved extension for additional clitoral or anal stimulation," and "unique sensuous feeling bringing your climax to amazing new heights." (*See id.*) The Touch Me device does not infringe upon independent claim 2, or claims 3 and 11, which are dependent upon claim 2, because it does not have the requisite "bend." (*See id.*)

Topco's Triple Pleaser only infringes upon claim 8 in that it provides a solid rod having a length with a first end and a second end constituting a gripping area. (*See* Dkt. 109, Ex. 28; *see also* TT, V3, Dkt. 112, 40:3-44:14.) An enlargement (or more specifically, "a region that is larger than the immediately adjacent area," as the term was defined at the *Markman* hearing) is integrally formed with the first end, and both the enlargement and the rod are made of generally lubricious glass-based material that is resistant to heat, chemicals, electricity, and bacterial absorption. (*See id.*)

(Cont'd)

> with other items that I had indicated before; porosity, face [phase] shift, grain size, and other issues.

(TT, V3, Dkt. 112, 81:10-18.) Topco failed to present any evidence to the contrary.

The device also provides a means for stimulating the user through the use of the sex aid for anal as well as vaginal stimulation. (*See id.*) The Court finds further evidence of infringement in the product's packaging, which describes "frictionless sensations," "unique multi-purpose design features G-Spot, clitoral, and erogenous massagers." (*See id.*) The device does not infringe independent claim 2, or dependent claims 6, 9, and 11, inasmuch as it does not have "a spherical enlargement integrally formed in the first end of the rod," does not include "a water-based lubricant to be used with the aid," and does not include "the step of utilizing the sex aid with a water-based lubricant." (*See id.*)

Topco's Heart's Delight infringes upon claims 2, 4, 8, and 11 in that it has a solid rod with a straight portion; a spherical enlargement integrally formed with a first end of the rod; a second end of the rod constituting a gripping area that is in the form of a loop; and a bend at an obtuse angle. (*See* Dkt. 109, Ex. 30; see *also* TT, V3, Dkt. 112, 26:6-28:21.) Also, the device is made entirely of generally lubricious glass-based material that is resistant to heat, chemicals, electricity, and bacterial absorption. (*See id.*) The device comes with a package of water-based lubricant and provides a means for stimulating the user during sex acts through the use of the sex aid for anal as well as vaginal stimulation. (*See id.*) The Court finds further evidence of infringement in the product's packaging, which describes use in terms of "frictionless sensations" and "sleek glass dildo has a smooth contour design, and "the smooth contour design stimulates your G-spot for orgasmic thrills." (*See id.*)

Appendix B

Topco's Spiral G infringes upon claims 2, 3, 8, and 11 in that it has a solid rod with a straight portion; a spherical enlargement integrally formed with (or "generally continuous with, part of," as the terms "integrally formed with" were construed at the *Markman* hearing) a first end of the rod; plural enlargements; a second end of the rod constituting a gripping area; and a bend at an obtuse angle. (*See* Dkt. 109, Ex. 31; see *also* TT, V3, Dkt. 112, 44:16-46:15.) Further, the device is made entirely of generally lubricious glass-based material that is resistant to heat, chemicals, electricity, and bacterial absorption. (*See id.*) The device comes with a package of water-based lubricant and provides a means for stimulating the user during sex acts through the use of the sex aid for anal as well as vaginal stimulation. (*See id.*) The Court finds additional evidence of infringement in the product's packaging, which describes "sexy, slippery sensations, the unique sensuous feel of the E-glass brings your climax to amazing new heights." (*See id.*)

Topco's G-Spot Lover infringes upon claims 2, 3, 8, and 11, in that it has a solid rod with a straight portion; a spherical enlargement integrally formed with a first end of the rod; plural enlargements; a second end of the rod constituting a gripping area; and a bend at an obtuse angle. (*See* Dkt. 109, Ex. 32; *see also* TT, V3, Dkt. 112, 8:22-16:22.) Also, the device is made entirely of generally lubricious glass-based material that is resistant to heat, chemicals, electricity, and bacterial absorption. (*See id.*) The device comes with a package of water-based lubricant and provides a means for

stimulating the user during sex acts through the use of the sex aid for anal as well as vaginal stimulation. (See *id.*) The Court finds further evidence of infringement in the product's packaging, which describes the device in terms of providing "frictionless sensations," "maximum clit stimulation," having "the unique sensuous feel of E-Glass," that it "will bring your climax to amazing new heights," and having "an ultra-soft cockring with ticklers" included." (*See id.*)

Topco's Pink Indulgence infringes upon claim 8 in that it has a solid rod with a length; an enlargement integrally formed with a first end of the rod; and a second end of the rod constituting a gripping area. (*See* Dkt. 109, Ex. 33; *see also* TT, V3, Dkt. 112, 35:18-37:25.) Also, this device is made entirely of generally lubricious glass-based material that is resistant to heat, chemicals, electricity, and bacterial absorption. (*See* Dkt. 109, Ex. 33; *see also* TT, V3, Dkt. 112, 35:18-37:25.) The device further provides a means for stimulating the user during sex acts through the use of the sex aid for anal as well as vaginal stimulation. (*See id.*) The Court finds additional evidence of infringement in the product's packaging, which describes the product's use in terms of "100% frictionless[7] sensations," "to ride your way to

---

7. Topco asserts that most of its glass devices are packaged with lubricant and, thus, when it uses the description "frictionless," it is in only in the lubricant context. However, no lubricant is packaged with Topco's Pink Indulgence (*see* dkt. 107, Ex. 33), the Petite Plug (*see id.* at Ex. 7H), the Triple Pleaser (*see id.* at Ex. 28), or the G Spot Lover (*see id.* at Ex. 32), yet those products are described products are described with the term "frictionless."

ecstasy with the Pink Indulgence, experience unparalleled pleasure with super slippery sensations, and the textured bumps and grooves for waves of pleasure" (*See id.*) The device does not infringe upon independent claim 2 or dependent claims 3 and 11 because an examination of this device actually shows that the first end of the device has a partial sphere that tapers into a cone. (*See id.*) This does not constitute a "spherical" enlargement inasmuch as that term was construed as "rounded, like a globe or ball" at the *Markman* hearing. (*See* Dkt. 71, 58:5.)

Topco's Pure Pleasure infringes upon claim 8 in that it provides a solid rod having a length with a first end and a second end constituting a gripping area. (*See* Dkt. 109, Ex. 35; *see also* TT, V3, Dkt. 112, 46:17-47:13.) An enlargement is integrally formed with the first end, and both the enlargement and the rod are made of generally lubricious glass-based material that is resistant to heat, chemicals, electricity, and bacterial absorption. (*See id.*) The device comes with a package of water-based lubricant and provides a means for stimulating the user during sex acts through the use of the sex aid for anal as well as vaginal stimulation. (*See id.*) The Court finds further evidence of infringement in the product's packaging, which describes it usage in terms of "frictionless sensations," "sexy, slippery sensations, the unique sensuous feel of the E-glass will bring your climax to amazing new heights," "features four pleasure balls for easy control and waves of pleasure," and "ride your way to ecstasy with Pure Pleasure E-glass Massager." (*See id.*)

Appendix B

Topco's Spine infringes upon claim 8 in that it provides a solid rod having a length with a first end and a second end constituting a gripping area. (See Dkt. 109, Ex. 36; *see also* TT, V3, Dkt. 112, 16:23-24:8.) An enlargement is integrally formed with the first end, and both the enlargement and the rod are made of generally lubricious glass-based material that is resistant to heat, chemicals, electricity, and bacterial absorption. (*See id.*) The device comes with a package of water-based lubricant and provides a means for stimulating the user during sex acts through the use of the sex aid for anal as well as vaginal stimulation. (*See id.*) The Court finds further evidence of infringement in the product's packaging, which describes it usage in terms of "sexy, slippery sensations, the unique, sensual feel of E-glass will bring your climax to amazing new heights." (*See id.*)

Topco's Petite Plug infringes upon claim 8 in that it provides a solid rod having a length with a first end and a second end constituting a gripping area. (Dkt. 107, Ex. 7H; *see also* TT, V3, Dkt. 112, 54:9-56:22.) An enlargement is integrally formed with the first end, and both the enlargement and the rod are made of generally lubricious glass-based material that is resistant to heat, chemicals, electricity, and bacterial absorption. (*See id.*) The device also provides a means for stimulating the user during sex acts through the use of the sex aid for anal as well as vaginal stimulation. (*See id.*) The Court finds further evidence of infringement in the product's packaging, which describes its usage in terms of "virtually frictionless sensations." (*See id.*)

Appendix B

Dr. Stern only testified as to 9 of the 11 Topco devices that are alleged to infringe, because the remaining two items were missing from either the pretrial statement, or the expert's report. Reynard testified as to the basis of Plaintiffs' infringement claims as to these two items. The Court finds as follows:

Topco's Crystal Plug infringes upon claim 8 in that it provides a solid rod having a length with a first end and a second end constituting a gripping area. (Dkt. 109, Ex. 27; *see also* TT, V1, Dkt. 110, 67:18-69:11.) An enlargement is integrally formed with the first end, and both the enlargement and the rod are made of generally lubricious glass-based material that is resistant to heat, chemicals, electricity, and bacterial absorption. (*See id.*) The device comes with a package of water-based lubricant and provides a means for stimulating the user during sex acts through the use of the sex aid for anal as well as vaginal stimulation. (*See id.*) The Court finds further evidence of infringement in the product's packaging, which describes the device as featuring "a gently flared shaft, a wide base for safe, comfortable anal play." (*See id.*)

Topco's Confetti Curve does not infringe upon independent claims 2 and 8, or dependent claims 6, 9, and 11, because it is not comprised of a rod, as required by those claims. "Rod" has been defined to mean "generally straight with an elongated appearance." (Dkt. 71, 80:13.) Confetti Curve is curved in its entirety. (*See* Dkt. 109, Ex. 29).

Appendix B

2. Further Discussion of Method Claim 8

To infringe upon a method claim, "all of the steps of the process must be performed." *See Monsanto Co. v. Syngenta Seeds, Inc.*, 503 F.3d 1352, 1359 (Fed. Cir. 2007). Method claim 8 has three steps for using a sex aid to increase stimulation during sex acts. Steps 1 and 2 are "providing" steps: (1) "providing a rod" with particular structure and (2) providing additional structure to the rod wherein it contains "an appreciable amount of an oxide of boron to render it lubricious, etc." (*See* Dkt. 107, Ex. 1B.) Step 3 then requires using the sex aid during anal as well as vaginal stimulation (although not "simultaneously," as Topco repeatedly urges in its briefs) to give greater stimulation. (*See id.*) As discussed above, the Court finds that the following Topco devices infringe upon all steps of claim 8, either directly or indirectly, through inducement: Touch Me, Heart's Delight, Triple Pleaser, Spiral G, G Spot Lover, Pink Indulgence, Pure Pleasure, Spine Petite Plug, and Crystal Plug. (Dkt. 109, Exs. 26; 27; 28; 30; 31; 32; 33; 35; 36; 7H.)

With respect to step 3, the Court's infringement determination is based upon Plaintiffs' presentation of a preponderance of circumstantial evidence that Topco induces end users of the devices to infringe upon the patent claim. The advertising, viewed in conjunction with Topco's admitted product sales, reveals that the devices have no non-infringing use and that infringing use is encouraged. Topco's packaging, as discussed above, and pages from websites where Topco's devices

are sold (Dkt. 107, Composite Ex. 7), contain explicit language describing the devices in terms of their function and intended use. All of this advertising gives rise to a logical inference that Topco consumers use the devices during sex acts to achieve greater stimulation during anal, as well as vaginal stimulation, so as to infringe upon the language of claim 8.[8] And, as Plaintiffs point out, the devices at issue are not found in local shopping markets, and are limited to sale in adult-related, sexually oriented shops, vendors, and web sites. While Topco argues that there are other substantial, non-infringing uses for the products at issue, it did not present any evidence to show that its devices can be found in any other locations. Topco also cannot dispute the above-described advertising of its products. *See Chiuminatta Concrete Concepts. Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1312 (Fed. Cir. 1998) (finding that alleged infringer's advertisements conceded the ability of the accused device to practice the claimed method, and encouraged such use); *Moleculon Research*

---

8. Plaintiffs also requested the court to take judicial notice of societal mores and sexual attitudes in determining infringement of step 3. Topco responds that courts can take notice of certain facts without formal proof, but only where the fact in question is "one not subject to reasonable dispute in that it is either: (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." *Shahar v. Bowes*, 120 F.3d 211, 214 (11th Cir. 1997) (citations omitted). Topco may be correct in its assertion; however, the Court simply cannot put aside its own common sense and logic as to the intended use of these devices.

Corp. v. CBS, Inc., 793 F.2d 1261, 1272 (Fed. Cir. 1986) (rejecting the argument that "proof of inducing infringement or direct infringement requires direct, as opposed to circumstantial evidence").

C. Remedies

1. Actual Damages/Lost Profits

Plaintiffs were not in the business of selling borosilicate glass sex aids and did not compete with Topco even if KME, of which they are the sole shareholders, competed with Topco. (TT, V3, Dkt. 112, 122:18-123:13.) Thus, Plaintiffs lack standing to obtain any lost profits suffered by KME, the corporation of which they are shareholders. *See Poly-America. L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303, 1311 (Fed. Cir. 2004) (holding that where one company held the patent and a related company made and sold the product, the patent owner could not recover the maker and seller's lost profits). In ruling on Topco's motion for judgment as a matter of law, pursuant to Rule 52(c), Federal Rules of Civil Procedure, the Court found that the *Poly-America* case governs as to Plaintiffs' claim for actual damages and lost profits. (*See* TT, V3, Dkt. 112, 122:18-25;123:1-13.) Accordingly, Plaintiffs as individuals suffered no actual damages or lost profits and lack standing to recover such.

Appendix B

2. Royalty

Despite lacking standing or evidence to obtain lost profits, a plaintiff may recover a reasonable royalty if they prevail on liability. *See* 35 U.S.C. § 284. A reasonable royalty is the royalty that the patent holder and infringer would agree to during a hypothetical negotiation in which both parties are willing to negotiate. *See Micro Chem., Inc. v. Lextron, Inc.*, 317 F.3d 1387, 1393 (Fed. Cir. 2003). The hypothetical negotiation occurs when infringement begins. *See Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1078 (Fed. Cir. 1983).

A patentee can collect a reasonable royalty for the infringer's sales. It cannot obtain royalties for all persons in the accused infringer's distribution chain. "In the usual course of events, the length of the accused manufacturer's distribution chain should have no impact on the patentee's ability to be made whole by the manufacturer. Indeed, in most cases damages assessed for indirect infringement will be equal to damages assessed for the underlying direct infringement." *Glenayre Elecs., Inc. v. Jackson*, 443 F.3d 851, 859 (Fed. Cir. 2006). A patentee may not recover damages against the infringer for its indirect infringement after the patent owner already obtained a judgment based on the infringer's direct infringer. *Id.*

Plaintiffs seek royalties in the amount of $5.6 million. To arrive at this figure, they look first to Topco's counsel's opening statement that the evidence would

show Topco's sales of about $700,000 for all 14 products originally accused of infringement. (*See* TT, V1, Dkt. 110, 19:8-15.) Plaintiffs then multiply that figure by a 400% profit margin based upon there being a number of purchase and sale points (distributors, wholesalers, and retailers) between the manufacturer and the end user. However, Plaintiffs presented no evidence whatsoever as to Topco's supply chain or profit margins. Ritchie merely speculated on the profit margin based upon his experience working for Eckerd Drug. (*See id.* at 215:21-24.) Furthermore, to arrive at a final royalty demand of $5.6 million, Plaintiffs had to multiply the $700,000 in Topco sales by 800%, rather than 400%, but provided no explanation as to the 800% mark up.

Plaintiffs failed to introduce any evidence whatsoever of Topco's per item sales, dollars and units, or evidence of the sales of each accused device. Plaintiffs failed to present any evidence from an accountant, economist, or other expert on the subject of royalties. Further, Plaintiffs and KME failed to mark the patent number on devices they sold and such failure to mark precludes the award of damages unless an infringer was notified of its infringement and subsequently continued to infringe. *See* 35 U.S.C. § 287(a). Topco is not liable for damages for sales of any devices before plaintiffs actually notified Topco that the particular device infringed. *See Amsted Indus, Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994). The filing of the Complaint in this action, in November 2006, served as Topcos' first notice of the '924 patent. *Id.* at 1112-13. Plaintiffs' royalty demand fails to take this factor into account.

Plaintiffs' royalty demand also fails to take into account the following factors:

> (1) KME made no profit for every year except one from 2000 to 2007, when it made a small profit. (Dkt. 107, Ex. 4a-4i);
>
> (2) Plaintiffs' license would have been non-exclusive because KME was selling its own products;
>
> (3) Topco sells many other products;
>
> (4) KME and Topco do not compete with each other. Topco sells through distributors, who in turn sell to retailer sex stores. KME limits its sales to the Internet and at sex conventions. and, thus, Topco's sales would not necessarily diminish KME's sales; and;
>
> (5) One company responded after Plaintiffs mailed out about 100 letters to glass sex aid manufacturers, requesting that each manufacturer accept a license under the '924 patent. (TT, V2, 111, 96:18-21.) No one responded with a sincere offer. (*Id.* at 97:8-10.)

Though Plaintiffs may be entitled to a reasonable royalty, they have the burden to support the amount of the royalty with admissible evidence. *See generally, Lindemann Maschinenfabrik GmbH v. American*

Hoist & Derrick Co., 895 F.2d 1403, 1407-08 (Fed. Cir. 1990); *see also Devex Corp. v. General Motors Corp.*, 667 F.2d 347, 363 (3d Cir. 1981) (affirming award of zero damages for lack of evidence and stating: "The statute [35 U.S.C. § 284] requires the award of a reasonable royalty, but to argue that this requirement exists even in the absence of any evidence from which a court may derive a reasonable royalty goes beyond the possible meaning of the statute."). Because of Plaintiffs' failure to introduce such evidence, they are entitled to no reasonable royalty.

3. Injunctive Relief

In their Complaint, Plaintiffs seek injunctive relief in the form of:

> Permanently enjoining Defendants and their principals, shareholders, officers, directors, employees, successors, assigns, suppliers, agents, servants, and attorneys, and all those persons in active concert, participation or privity with them, or any of them from making using selling offering for sale, or offering for others to use items that would constitute an infringement of the '924 patent.

Plaintiffs did not raise the issue of injunctive relief in their pretrial statement, trial brief, at trial, in their post-trial brief, rebuttal brief, or findings of fact and conclusions of law. However, a court may enter a permanent injunction after a final judgment of

infringement in accord with principals of equity. *See* 35 U.S.C. § 283. To obtain a permanent injunction, the plaintiff must satisfy a four-factor test, similar to the test used for preliminary injunctions. *See eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006). A plaintiff must show:

> (1) that it suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.

Id. In light of the Court's previous infringement analysis, it finds that the four-factor test has been met in this case and that Plaintiffs are entitled to the injunctive relief requested.

4. Attorney Fees

35 U.S.C. § 285 provides that the "court in exceptional cases may award reasonable attorney fees to the prevailing party." Bad faith litigation and inequitable conduct may render a case exceptional. *See Mahurkar v. C.R. Bard. Inc.*, 79 F.3d 1572, 1579 (Fed. Cir. 1996). Additionally, a finding of willful infringement may be sufficient grounds for an award of attorney fees. See *Avia Group Intl, Inc. v. L.A. Gear Cal., Inc.*, 853

F.2d 1557, 1567 (Fed. Cir. 1988). The circumstances which might render a case "exceptional" do not exist in this case and, thus, an award of fees is not appropriate.

ACCORDINGLY, it is **ORDERED AND ADJUDGED:**

1. As a matter of law, all claims of the '924 patent are valid and enforceable.

2. As a matter of law, the following Topco products infringe upon claims of the '924 patent:

Touch Me (Dkt. 109, Ex. 26):	claim 8
Triple Pleaser (Dkt. 109, Ex. 28):	claim 8
Heart's Delight (Dkt. 109, Ex. 30):	claims 2, 4, 8, 11
Spiral G (Dkt. 109, Ex. 31):	claims 2, 3, 8, 11
G Spot Lover (Dkt. 109, Ex. 32):	claims 2, 3, 8, 11
Pink Indulgence (Dkt. 109, Ex. 33):	claim 8
Pure Pleasure (Dkt. 109, Ex. 35):	claim 8
Spine (Dkt. 109, Ex. 36):	claim 8
Petite Plug (Dkt. 107, Ex. 7H):	claim 8
Crystal Plug (Dkt. 109, Ex. 27):	claim 8

3. As a matter of law, Topco, its principals, shareholders, officers, directors, employees, successors, assigns, suppliers, agents, servants, and attorneys, and all those persons in active concert, participation, or privity with them, or any of them, are permanently enjoined from making, using, selling, offering for sale, or offering for others to use the items listed above in paragraph 2, or items with no more than colorable differences from those items, as a remedy for the patent infringement.

4. As a matter of law, Plaintiffs lack standing to recover actual damages or lost profits damages.

5. As a matter of law, Plaintiffs are entitled to no reasonable royalty.

6. As a matter of law, Plaintiffs are not entitled to an award of attorney fees.

7. The Clerk is directed to enter an amended judgment for Plaintiffs and to close this case.

DONE AND ORDERED at Tampa, Florida, on July 24, 2008.

s/ Richard A. Lazzara
RICHARD A. LAZZARA
UNITED STATES DISTRICT JUDGE

COPIES FURNISHED TO:
Counsel of Record

APPENDIX C — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING DATED AND FILED JUNE 25, 2009

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2008-1528, -1529

STEVEN D. RITCHIE and H. DAVID REYNARD
(as Trustee for the Harlie David Reynard, Jr. Revocable Trust),

Plaintiffs-Appellants,

v.

VAST RESOURCES, INC.
(doing business as Topco Sales),

Defendant-Cross Appellant.

Appealed from: United States District Court for the Middle District of Florida

Judge Richard A. Lazzara

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the Appellants, and a response thereto having been invited by the court and filed by the Cross-Appellant, and the petition for

rehearing and response, having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on July 2, 2009.

FOR THE COURT,

s/ Jan Horbaly
Jan Horbaly
Clerk

Dated: 06/25/2009

APPENDIX D — RELEVANT STATUTES

15 U.S.C.A. § 1121

§ 1121. Jurisdiction of Federal courts; State and local requirements that registered trademarks be altered or displayed differently; prohibition

(a) The district and territorial courts of the United States shall have original jurisdiction and the courts of appeal of the United States (other than the United States Court of Appeals for the Federal Circuit) shall have appellate jurisdiction, of all actions arising under this chapter, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties.

(b) No State or other jurisdiction of the United States or any political subdivision or any agency thereof may require alteration of a registered mark, or require that additional trademarks, service marks, trade names, or corporate names that may be associated with or incorporated into the registered mark be displayed in the mark in a manner differing from the display of such additional trademarks, service marks, trade names, or corporate names contemplated by the registered mark as exhibited in the certificate of registration issued by the United States Patent and Trademark Office.

Appendix D

28 U.S.C.A. § 1292

§ 1292. Interlocutory decisions

(a) Except as provided in subsections (c) and (d) of this section, the courts of appeals shall have jurisdiction of appeals from:

(1) Interlocutory orders of the district courts of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to dissolve or modify injunctions, except where a direct review may be had in the Supreme Court;

(2) Interlocutory orders appointing receivers, or refusing orders to wind up receiverships or to take steps to accomplish the purposes thereof, such as directing sales or other disposals of property;

(3) Interlocutory decrees of such district courts or the judges thereof determining the rights and liabilities of the parties to admiralty cases in which appeals from final decrees are allowed.

(b) When a district judge, in making in a civil action an order not otherwise appealable under this section, shall be of the opinion that such order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an

immediate appeal from the order may materially advance the ultimate termination of the litigation, he shall so state in writing in such order. The Court of Appeals which would have jurisdiction of an appeal of such action may thereupon, in its discretion, permit an appeal to be taken from such order, if application is made to it within ten days after the entry of the order: *Provided, however,* That application for an appeal hereunder shall not stay proceedings in the district court unless the district judge or the Court of Appeals or a judge thereof shall so order.

(c) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction—

(1) of an appeal from an interlocutory order or decree described in subsection (a) or (b) of this section in any case over which the court would have jurisdiction of an appeal under *section 1295* of this title; and

(2) of an appeal from a judgment in a civil action for patent infringement which would otherwise be appealable to the United States Court of Appeals for the Federal Circuit and is final except for an accounting.

(d)(1) When the chief judge of the Court of International Trade issues an order under the provisions of *section 256(b)* of this title, or when any judge of the Court of International Trade, in issuing any other interlocutory order, includes in the order a statement that a controlling question of law is involved with respect to which there is a substantial ground for difference of

opinion and that an immediate appeal from that order may materially advance the ultimate termination of the litigation, the United States Court of Appeals for the Federal Circuit may, in its discretion, permit an appeal to be taken from such order, if application is made to that Court within ten days after the entry of such order.

(2) When the chief judge of the United States Court of Federal Claims issues an order under *section 798(b)* of this title, or when any judge of the United States Court of Federal Claims, in issuing an interlocutory order, includes in the order a statement that a controlling question of law is involved with respect to which there is a substantial ground for difference of opinion and that an immediate appeal from that order may materially advance the ultimate termination of the litigation, the United States Court of Appeals for the Federal Circuit may, in its discretion, permit an appeal to be taken from such order, if application is made to that Court within ten days after the entry of such order.

(3) Neither the application for nor the granting of an appeal under this subsection shall stay proceedings in the Court of International Trade or in the Court of Federal Claims, as the case may be, unless a stay is ordered by a judge of the Court of International Trade or of the Court of Federal Claims or by the United States Court of Appeals for the Federal Circuit or a judge of that court.

(4)(A) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction of an appeal from an interlocutory order of a district court of the United States, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, granting or denying, in whole or in part, a motion to transfer an action to the United States Court of Federal Claims under *section 1631* of this title.

(B) When a motion to transfer an action to the Court of Federal Claims is filed in a district court, no further proceedings shall be taken in the district court until 60 days after the court has ruled upon the motion. If an appeal is taken from the district court's grant or denial of the motion, proceedings shall be further stayed until the appeal has been decided by the Court of Appeals for the Federal Circuit. The stay of proceedings in the district court shall not bar the granting of preliminary or injunctive relief, where appropriate and where expedition is reasonably necessary. However, during the period in which proceedings are stayed as provided in this subparagraph, no transfer to the Court of Federal Claims pursuant to the motion shall be carried out.

(e) The Supreme Court may prescribe rules, in accordance with *section 2072* of this title, to provide for an appeal of an interlocutory decision to the courts of appeals that is not otherwise provided for under subsection (a), (b), (c), or (d).

Appendix D

28 U.S.C.A. § 1338

§ 1338. Patents, plant variety protection, copyrights, mask works, designs, trademarks, and unfair competition

(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.

(b) The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent, plant variety protection or trademark laws.

(c) Subsections (a) and (b) apply to exclusive rights in mask works under chapter 9 of title 17, and to exclusive rights in designs under chapter 13 of title 17, to the same extent as such subsections apply to copyrights.

Appendix D

35 U.S.C.A. § 271

§ 271. Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory

infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement; (4) refused to license or use any rights to the patent; or (5) conditioned the license of any rights to the patent or the sale of the patented product on the acquisition of a license to rights in another patent or purchase of a separate product, unless, in view of the circumstances, the patent owner has market power in the relevant market for the patent or patented product on which the license or sale is conditioned.

(e)(1) It shall not be an act of infringement to make, use, offer to sell, or sell within the United States or import into the United States a patented invention (other than a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Act of March 4, 1913) which is primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques) solely for uses reasonably related to the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs or veterinary biological products.

(2) It shall be an act of infringement to submit—

(A) an application under section 505(j) of the Federal Food, Drug, and Cosmetic Act or described in section 505(b)(2) of such Act for a drug claimed in a patent or the use of which is claimed in a patent, or

(B) an application under section 512 of such Act or under the Act of March 4, 1913 (*21 U.S.C. 151-158*) for a drug or veterinary biological product which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques and which is claimed in a patent or the use of which is claimed in a patent,

if the purpose of such submission is to obtain approval under such Act to engage in the commercial manufacture, use, or sale of a drug or veterinary biological product claimed in a patent or the use of which is claimed in a patent before the expiration of such patent.

(3) In any action for patent infringement brought under this section, no injunctive or other relief may be granted which would prohibit the making, using, offering to sell, or selling within the United States or importing into the United States of a patented invention under paragraph (1).

(4) For an act of infringement described in paragraph (2)—

(A) the court shall order the effective date of any approval of the drug or veterinary biological product involved in the infringement to be a date which is not earlier than the date of the expiration of the patent which has been infringed,

(B) injunctive relief may be granted against an infringer to prevent the commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product, and

(C) damages or other monetary relief may be awarded against an infringer only if there has been commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product.

The remedies prescribed by subparagraphs (A), (B), and (C) are the only remedies which may be granted by a court for an act of infringement described in paragraph (2), except that a court may award attorney fees under *section 285.*

(5) Where a person has filed an application described in paragraph (2) that includes a certification under subsection (b)(2)(A)(iv) or (j)(2)(A)(vii)(IV) of section 505 of the Federal Food, Drug, and Cosmetic Act (*21 U.S.C. 355*), and neither the owner of the patent that

is the subject of the certification nor the holder of the approved application under subsection (b) of such section for the drug that is claimed by the patent or a use of which is claimed by the patent brought an action for infringement of such patent before the expiration of 45 days after the date on which the notice given under subsection (b)(3) or (j)(2)(B) of such section was received, the courts of the United States shall, to the extent consistent with the Constitution, have subject matter jurisdiction in any action brought by such person under *section 2201 of title 28* for a declaratory judgment that such patent is invalid or not infringed.

(f)(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United

States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(g) Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use of the product occurs during the term of such process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product. A product which is made by a patented process will, for purposes of this title, not be considered to be so made after—

(1) it is materially changed by subsequent processes; or

(2) it becomes a trivial and nonessential component of another product.

(h) As used in this section, the term "whoever" includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.

Appendix D

(i) As used in this section, an "offer for sale" or an "offer to sell" by a person other than the patentee, or any designee of the patentee, is that in which the sale will occur before the expiration of the term of the patent.

131

No. 09-97 (2)

Supreme Court, U.S.
FILED
AUG 21 2009
OFFICE OF THE CLERK

In The Supreme Court Of The United States

STEVEN D. RITCHIE, *et al.*,

Petitioners,

v.

VAST RESOURCES, INC.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Michael D. Harris
Counsel of Record
Steven Sereboff
M. Kala Sarvaiya
SoCal IP Law Group LLP
310 North Westlake Boulevard, Suite 120
Westlake Village, California 91362
(805) 230-1350

Counsel for Respondent

Dated: August 21, 2009

THE LEX GROUP^{DC} • 1750 K Street N.W. • Suite 475 • Washington, DC 20006
(202) 955-0001 • (800) 815-3791 • Fax: (202) 955-0022 • www.thelexgroupdc.com

A. Questions Presented

1. Have petitioners presented compelling reasons to revisit patent obviousness under 35 U.S.C. § 103(a) when the Federal Circuit invalidated the patent by following this Court's two-year-old ruling in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007)?

2. Have petitioners presented compelling reasons to grant the petition where the purported conflict between court of appeals' decisions is from the same court, the Federal Circuit, different facts in the respective cases caused any differences in the decisions, one case applied the rule this Court rejected in *KSR*, and the decisions do not conflict?

3. Have petitioners presented compelling reasons to grant the petition simply because the Federal Circuit chose not to discuss purported evidence of commercial success, a secondary consideration of non-obviousness in its opinion holding the patent invalid as obvious?

B. Corporate Disclosure Statement Pursuant to Supreme Court Rule 29.6

Respondent Vast Resources, Inc. d.b.a. Topco Sales does not have a parent corporation, and no publically held company owns 10% of more of its stock.

C. Table of Contents

Page

A. Questions Presented i

B. Corporate Disclosure Statement Pursuant to Supreme Court Rule 29.6 ii

C. Table of Contents iii

D. Table of Authorities v

E. Introduction 1

F. Statement of the Case 3

G. Petitioners Failed to Show compelling Reasons for Granting Certiorari 7

1. The Court of Appeals Followed *KSR* and this Court's Other Commercial Success Precedent 7

2. No Compelling Reasons Exist to Revisit This Court's Past Rulings that Evidence of Commercial Success Might Affect a Close Case Because This Case is Not Close 11

3. No Compelling Reasons Exist to Examine the Federal Circuit's Treatment of Commercial Success Because Petitioners Failed to Show Commercial Success 13

4. The Federal Circuit Was Not Required to Mention Every Ground that Petitioners Wanted 16

5. The Federal Circuit's Decision Here Does Not Conflict with *Stratoflex*, *Ruiz* or the Unpublished *Andersen* Case 18

H. Conclusion 22

D. Table of Authorities

Page(s)

Cases

Agrizap, Inc. v. Woodstream Corp.,
520 F.3d 1337 (Fed. Cir. 2008)..... 13

Andersen Corp. v. Pella Corp.,
2008 U.S. App. LEXIS 24087
(Fed. Cir. Nov. 19, 2008), (unpublished),
cert. denied,
129 S. Ct. 2739 (2009) 18, 20, 21

Anderson's-Black Rock, Inc. v.
Pavement Salvage Co.,
396 U.S. 57 (1969) 2, 9

Calmar, Inc. v. Cook Chemical Co.,
336 F.2d 36 (8th Cir. 1964) 9

Cardinal Chem. Co. v. Morton Int'l, Inc.,
505 U.S. 83 (1993) 18

In re DBC,
545 F.3d 1373 (Fed. Cir. 2008)..... 15

Demaco Corp. v.
F. Von Langsdorff Licensing Ltd.,
851 F.2d 1387 (Fed. Cir. 1988)..... 13

Dow Chem. Co. v.
Halliburton Oil Well Cementing Co.,
324 U.S. 320 (1945) 10

eBay Inc. v. MercExchange, LLC,
457 U.S. 388 (2006) 5

E.M. Labs., Inc. v. United States,
80 Cust. Ct. 125 (Cust. Ct. 1978) 12

General Elec. Co. v.
Jewel Incandescent Lamp Co.,
326 U.S. 242 (1945) 10

Goodyear Tire & Rubber Co. v.
Ray-O-VacCo.,
321 U.S. 275 (1944) 2, 10, 11

Graham v. John Deere Co.,
383 U.S. 1 (1966) 7, 9

Great Atl. & Pac. Tea Co. v.
Supermarket Corp.,
340 U.S. 147 (1950) 2, 9

Hotchkiss v. Greenwood,
52 U.S. 248 (11 How. 1851) 7, 12, 22

Iron Grip Barbell Co. v. USA Sports, Inc.,
392 F.3d 1317 (Fed. Cir. 2004) 16

Jungersen v. Ostby & Barton Co.,
335 U.S. 560 (1949) 9-10

KSR Int'l Co. v. Teleflex Inc.,
550 U.S. 398 (2007) ..... *passim*

Kansas Jack, Inc. v. Kuhn,
719 F.2d 1144 (Fed. Cir. 1983) 13, 14

Leapfrog Enter., Inc. v. Fisher-Price, Inc.,
485 F.3d 1157 (Fed. Cir. 2007)..... 13

Lowder v. Dep't of Homeland Sec.,
504 F.3d 1378 (Fed. Cir. 2007)..... 16-17

Perkin-Elmer Corp. v. Computervision Corp.,
732 F.2d 888 (Fed. Cir. 1984) 17

Ritchie v. Vast Resources, Inc.,
563 F.3d 1334 (Fed. Cir. 2009).....*passim*

Ruiz v. A.B. Chance Co.,
234 F.3d 654 (Fed. Cir. 2000) 18, 21

Ruiz v. A.B. Chance Co.,
357 F.3d 1270 (Fed. Cir. 2004)..... 21

Sakraida v. Ag Pro, Inc.,
425 U.S. 273 (1976) 8, 9

Schilling v. Schwitzer-Cummins Co.,
142 F.2d 82 (D.C. Cir. 1944) 17

Shinseki v. Sanders,
129 S. Ct. 1696 (2009) 18

Stratoflex, Inc. v. Aeroquip Corp.,
713 F.2d 1530 (Fed. Cir. 1983)..... 18, 19, 20

Taylor v. McKeithen,
407 U.S. 191 (1972) 16, 18

Transmatic, Inc. v. Gulton Indus., Inc.,
53 F.3d 1270 (Fed. Cir. 1995) 17

United States v. Garza,
165 F.3d 312 (5th Cir. 1999) 17

Walgreen Drug Stores v. Obear-Nester Glass Co.,
113 F.2d 956 (8th Cir. 1940) 12

Statutes

28 U.S.C. § 1295 18

35 U.S.C. § 103 ..... 6, 12

35 U.S.C. § 112 3

35 U.S.C. § 132 3

Rules

FED. CIR. R. 32.1(d) 20

FED. R. CIV. P. 52(a)(1) 17

SUP. CT. R. 10 2

E. Introduction

Petitioners Ritchie and Reynard seek to overturn a Federal Circuit decision invalidating a patent on Pyrex[1] glass sex toys, dildos, for obviousness in view of similarly shaped sex toys that have been made of glass since the Roman Empire. Pyrex is a hard glass that is less likely to break than conventional soda-lime glass when inserted into a human orifice. The prior art also taught other Pyrex device such as thermometers inserted into human orifices.

Pyrex performs no differently in sex toys than it performs in other glass devices. Regardless of whether the use is thermometers, cookware, laboratory glass or sex toys, Pyrex resists breaking and will not crack if heated quickly.

Thus, Pyrex performs predictably for sex toys. Further, if sex toy designers were dissatisfied with soda-lime glass sex toys, they would find texts and other prior art showing properties of a limited range of different glasses. They would choose those glasses best suited for sex toys. Choosing Pyrex would be obvious to try. Thus, petitioners' patent falls within this Court's obviousness guidelines recently stated in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

Petitioners do not claim the Federal Circuit is at odds with *KSR*'s obviousness analysis. They do not allege the Federal Circuit, district courts or the

---

[1] The patent claims the glass contains an oxide of boron. The Federal Circuit opinion referred to the borosilicate glass as Pyrex, and respondent does the same here.

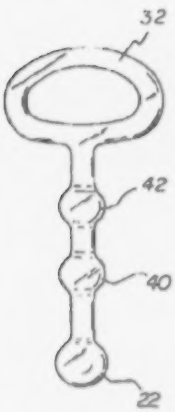
Patent and Trademark Office (PTO) need added guidance for obviousness rulings. Therefore, they show no compelling reason why this Court must involve itself. Petitioners complain that the Court in *KSR* discussed more factors to reach its obviousness conclusion than the Federal Circuit mentioned here. However, appellate courts can fashion their own opinions without exhaustively discussing every issue each party raises.

Petitioners' main criticism rests with the Federal Circuit's failure to weigh purported commercial success as heavily as petitioners want. Petitioners did not establish commercial success. Moreover, the Court rarely grants certiorari merely to correct facts. S. Ct. R. 10.

In the past 65 years, this Court eight times rejected patent holders' attempts to use alleged commercial success to save patents invalid for obviousness. Only one, *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275 (1944), upheld the patent, but even there commercial success was only one factor and was relevant only because it was "a *close case*." *Id.* at 279 (emphasis added). The other cases rejected commercial success evidence with language such as "commercial success 'without invention will not make patentability.'" *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 61 (1969) (quoting *Great Atl. & Pac. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 153 (1950)) ("*A&P*").

F. Statement of the Case

Petitioners Reissue Patent No. 38,928 (the '928 patent) titled "Sex Aid," shows several designs for glass sex toys. None has moving parts. One patent drawing is shown below:



Petitioners sued respondent Vast Resources, Inc. (d.b.a. Topco Sales) ("Topco")[2] for infringement, alleging 14 Topco Pyrex products infringed. Topco asserted defenses of non-infringement, invalidity based upon obviousness, lack of enablement, failure to disclose the best mode and indefiniteness under § 112,[3] and new matter under § 132. Topco also maintained the patent was unenforceable because the patentees intentionally withheld material prior art from the PTO.

Petitioners asserted several apparatus claims and several method claims. The apparatus claim used what the Federal Circuit called "troublesome" language, *Ritchie v. Vast Resources, Inc.*, 563 F.3d 1334, 1336 (Fed. Cir. 2009), which the court held claimed a Pyrex sex toy:

---

[2] Respondent is known in the trade as "Topco," and the trial court also used "Topco." Although the petition refers to respondent as "VRI," this opposition uses "Topco."

[3] Unless stated otherwise, all statutory references are to Title 35 of the United States Code.

> 2. A sexual aid comprising:
>
> a solid rod having a length with a first end and a second end constituting a gripping area; and
>
> a spherical enlargement integrally formed in the first end of the rod, the rod and enlargement being fabricated of a generally lubricious glass-based material containing an appreciable amount of an oxide of boron to render it lubricious and resistant to heat, chemicals, electricity and bacterial absorption, with the rod having a bend within its length between the gripping area and the first end having the spherical enlargement.

Pet. App. B, pp. 11a-12a. The method claims begin, "A method of using a sex aid to increase stimulation...." *Id.* p. 12a. Petitioners did not claim Topco practiced the method but contended Topco induced persons buying or using Topco's accused products to infringe.

After a bench trial, the court held the patent not invalid and held only three of the 14 accused Topco products infringed the apparatus claim, and ten (including the first three) infringed the method claim by inducement only. Thus, four did not infringe. The trial court awarded no lost-profit or reasonable royalty damages for lack of proof, and it permanently enjoined Topco.

Petitioners appealed the failure to award damages. They did not appeal the holding that 11 accused Topco products failed to infringe the apparatus claim.

Topco cross-appealed on invalidity (obviousness and lacking enablement). On infringement, Topco argued the trial court misinterpreted claim terms that it had determined differently before trial, or the court incorrectly applied those construed claims. Topco also urged that the trial court misapplied inducing law and this Court's injunction ruling in *eBay Inc. v. MercExchange, LLC*, 457 U.S. 388 (2006). The Federal Circuit stayed the injunction pending appeal.

The terse Federal Circuit opinion (Posner, J, by designation) dealt with one issue only—obviousness. The following quotations correctly applied obviousness law per *KSR*:

> Among the inventions that the law deems obvious are those modest, routine, everyday, incremental improvements of an existing product or process that confer commercial value (otherwise they would not be undertaken) but do not involve sufficient inventiveness to merit patent protection. This class of inventions is well illustrated by efforts at routine experimentation with different standard grades of a material used in a product—standard in the sense that

> their properties, composition, and method of creation are well known, making successful results of the experimentation predictable. This is such a case.

Ritchie, 563 F.3d at 1337.

> The plaintiffs' patent, however, with its vague reference to "appreciable amounts" of oxide of boron, does not claim any variant of off-the-shelf borosilicate glass. And since that is a standard product with well-known properties—including the properties listed in the patent—to experiment with substituting borosilicate glass for ordinary glass in a sexual device was not a venture into the unknown.

Id.

> This case thus exemplifies the Supreme Court's analysis in *KSR* .... "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar

> devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

Id. (citation omitted; quoting *KSR*, 550 U.S. at 417).

> And if more is required to make our point, there is the venerable case of *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 ... (1851), cited approvingly in *KSR* ..., 550 U.S. at 406, 415, which denied patentability to an invention consisting of the substitution of a clay or porcelain knob for a metallic or wood knob in a doorknob (the doorknob itself, as distinct from the knob on the end of it, being an assemblage of knob, shank, and spindle).

Id. at 1337-38.

G. Petitioners Failed to Show Compelling Reasons for Granting Certiorari

1. *The Court of Appeals Followed KSR and this Court's Other Commercial Success Precedent*

Petitioners argue that the Federal Circuit ignored or gave insufficient weight to commercial success. This Court consistently treats commercial success and other considerations as "secondary," which "might be utilized." *See, e.g., Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) ("[S]econdary considerations [such] as commercial success, long

felt but unsolved needs, [and] failure of others might be utilized ...").

From *KSR* back in time, the results were the same. In *KSR*, the trial court on summary judgment held the patent invalid for obviousness, and "the secondary factor of Teleflex's commercial success with pedals based on [the inventor's] design did not alter its conclusion." *KSR*, 550 U.S. at 413. Accordingly, Teleflex's declarations did not "prevent[] the District Court from reaching the careful conclusions underlying its order for summary judgment in this case." *Id.* at 427.

Eleven years earlier, *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976) (before the Federal Circuit's creation), invalidated a barn cleaning patent. The district court held:

> [E]ven if the combination filled a "long-felt want and... has enjoyed commercial success, those matters, without invention, will not make patentability." ... "[T]o those skilled in the art, the use of the old elements in combination was not an invention by the obvious-nonobvious standard. Even though the dairy barn in question attains the posture of a successful venture, more than that is needed for invention."

Id. at 278-79. This Court agreed. "Though doubtless a matter of great convenience, producing a desired result in a cheaper and faster way, and enjoying

commercial success, Dairy Establishment did not produce a new or different function... within the test of validity of combination patents. These desirable benefits without invention will not make patentability." *Id.* at 282-83 (citations and internal quotation marks omitted).

Six years earlier, *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), held a paving machine patent invalid as obvious. The machine simply combined four features from the prior art into a single machine. The patent holder "fervently argued that the combination filled a long felt want and has enjoyed commercial success. But those matters without invention will not make patentability." *Id.* at 61 (internal quotation marks omitted).

In *Graham* in 1964, the patent holder alleged, "[T]he long-felt need in the industry for a device such as [the inventor's] together with its wide commercial success supports its patentability." *Graham*, 383 U.S. at 35. This court still held the patent obvious. *Id.* at 36.[4]

Continuing back in time to *A&P* in 1950, the invention, a rolling frame to pull groceries to supermarket cashiers, "filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability." *A&P*, 340 U.S. at 153. Likewise, in *Jungersen v. Ostby & Barton Co.*, 335 U.S. 560

---

[4] *Graham* dealt with two appeals. Secondary considerations were mentioned only in the second appeal, the *Calmar, Inc. v. Cook Chemical Co.* portion.

(1949), the patent holder granted many licenses, and the invention was a commercial success. Nevertheless, "Where, as here, however, invention is plainly lacking, commercial success cannot fill the void. ... Commercial success is really a makeweight where the patentability question is close." *Id.* at 568.

Similarly, *General Elec. Co. v. Jewel Incandescent Lamp Co.*, 326 U.S. 242, 247-249 (1945), held a light bulb coating patent invalid for lacking invention despite commercial success. Along the same vein, "He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to achieve." *Dow Chem. Co. v. Halliburton Oil Well Cementing Co.*, 324 U.S. 320, 328 (1945). The patent holder claimed its "process has filled a long felt want and has been a commercial success. But these considerations are relevant only in a close case where all other proof leaves the question of invention in doubt." *Id.* at 330.

Finally, this Court in *Goodyear* upheld a patent against an obviousness challenge. The patent covered an improved flashlight battery. Prior art batteries leaked and damaged the flashlights. The battery industry knew about the problem for fifty years and failed to solve it. Once the inventor made his discovery, the industry saw the merits in the invention, and the invention became commercially successful. Therefore, the failure of others and commercial success "were entitled to weight in determining whether the improvement amounted to invention and should, in a close case, tip the scales

in favor of patentability." *Goodyear*, 321 U.S. at 278-279.

2. *No Compelling Reasons Exist to Revisit This Court's Past Rulings that Evidence of Commercial Success Might Affect a Close Case Because This Case is Not Close*

Petitioners/inventors' hired glass blowers who formed sex toys using existing, commercially available Pyrex rods. They used existing glass fabrication techniques to bend the rods and form enlargements to simulate erect penises. *See Ritchie*, 563 F.3d at 1337. ("The plaintiffs' patent, however, with its vague reference to "appreciable amounts" of oxide of boron, does not claim any variant of off-the-shelf borosilicate glass."). Pyrex acted predictably. Even petitioners' technical expert admitted that Pyrex acted as expected in sex toys. Responding to the question, "In the sex aid, the borosilicate glass is performing its expected function, correct?" he answered, "The glass itself, because of the fact that it has the oxide of boron added, provides, in a scientifically expected way, each of these characteristics." A3470. Petitioner Reynard answered, "Yes" when asked, "So what you did then with your invention is you took known properties of borosilicate glass and made a sex aid out of borosilicate glass to have those properties [resistant to temperature changes], right?" A3543.

Persons of ordinary skill in glass sex toys who want to make safer glass sex toys would look through standard texts on different glasses and pick the glass with desired properties. Similarly, they could search prior patents and learn about Pyrex thermometers for inserting into human orifices. If, somehow, they did not already know about Pyrex, they would learn that Pyrex is harder than soda-lime glass and resists cracking during rapid temperature changes. Thus, it stands out as the glass of choice. At the very least, one of ordinary skill would try Pyrex, and the "fact that a combination was obvious to try might show that it was obvious under § 103." *KSR*, 550 U.S. at 421. *See also E.M. Labs., Inc. v. United States*, 80 Cust. Ct. 125, 128 (Cust. Ct. 1978) (predating patent and referring to items "made largely of borosilicate glass, which is highly resistant to temperature changes" and other products made of "borosilicate glass which is more resistant to shock than is soda-lime glass.") Regarding another alleged advantage of Pyrex in sex toys, boiling them for sterilization, that property was well known. *See Walgreen Drug Stores v. Obear-Nester Glass Co.*, 113 F.2d 956, 963 (8th Cir. 1940) (Trademark suit dealing with glass nursing bottles recognizing that the "bottles were made of Pyrex glass so that they might be heated without injury.").

Substituting known materials in existing devices to obtain the materials' properties has been classic obviousness for at least 150 years since *Hotchkiss*, 52 U.S. (11 How.) at 266, as the Federal Circuit recognized. *Ritchie*, 563 F.3d at 1337-38.

Several post-*KSR* cases including two, *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344 (Fed. Cir. 2008), and *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), show the Federal Circuit holding even substantial evidence of commercial success or other secondary considerations will not overcome strong showings of obviousness. The Federal Circuit here followed this Court's obviousness rulings over the past 65 years.

3. *No Compelling Reasons Exist to Examine the Federal Circuit's Treatment of Commercial Success Because Petitioners Failed to Show Commercial Success*

The Federal Circuit has long required patentees relying on commercial success to show a "nexus between sales and the merits of the invention." *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151 (Fed. Cir. 1983). Nexus requirements are strict. Thus, *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988), requires proof that allegedly commercially successful products read on patent claims.

Here, petitioners cannot rely on its company's products because they introduced none in evidence. The trial court held only three of 14 Topco products infringed apparatus claim 2 (Topco disputes infringement). Unless the three infringing devices had been much more successful than the non-infringing ones (they were not), the invention's merits cannot have caused any commercial success.

Petitioners also mention other companies' Pyrex sex toys, but none was before the district court, and the patent claims require more than mere Pyrex content.

The 300,000 Google hits for "glass dildo" that petitioners mention were meaningless without evidence interpreting Google search results. Therefore, the hits do not establish nexus. Further, petitioner Reynard admitted duplicate hits existed, but he did not view every entry. "I looked through the first couple of pages of entries." "I'm not sure how the counts calculated but in some cases, there would be multiple entries ...." A3073. In addition, a hit for "glass dildo" could refer to this suit, prior art and books about glass sex toys (several prior art books that use the phrase were in evidence).

The Federal Circuit requires patent holders seeking to rely on commercial success to put sales in context with sales of competing products. *Kansas Jack*, 719 F.2d at 1151 (Fed. Cir. 1983) (holding the number of units sold is irrelevant "without evidence of market share, of growth in market share, of replacing earlier units sold by others or of dollar amounts ....") Petitioners presented no such evidence.

Petitioners complain that the Federal Circuit "alluded to 'skillful marketing' to argue against commercial success." Pet. p. 8. That is not what the court did. It merely noted, "The commercial success of a product can have many causes unrelated to patentable inventiveness; for example, the commercial success of an 'invention' *might be due* not to the invention itself but to skillful marketing of the

product embodying the invention." *Ritchie*, 563 F.3d at 1336 (emphasis added). The quotation acknowledges that a patentee seeking to rely on commercial success or other secondary consideration must prove that the invention's merits, not other factors, caused any success.

> "[E]vidence of commercial success alone is not sufficient to demonstrate nonobviousness of a claimed invention. Rather, the proponent must offer proof 'that the sales were a direct result of the unique characteristics of the claimed invention—as opposed to other economic and commercial factors unrelated to the quality of the patented subject matter.'"

In re DBC, 545 F.3d 1373, 1384 (Fed. Cir. 2008) (citation omitted and holding $130 million in sales in two years did not support commercial success nexus).

Petitioners have not argued changing the burden of proof for commercial success and nexus. They also did not show a compelling reason for this Court to review the burdens.

Petitioners also mention other secondary considerations of non-obviousness. They claim the entire industry copied them. However, they introduced no evidence that the industry copied either petitioners' claimed invention or their commercial products. "Not every competing product

that arguably falls within the scope of a patent is evidence of copying. Otherwise, every infringement suit would automatically confirm the nonobviousness of the patent. Rather, copying requires the replication of a specific product." *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325.

Finally, petitioners complain that the Federal Circuit here did not discuss a problem they believe their patent solved—odor retention in prior art sex toys. However, they refer to plastic and other materials as if the prior art contained no glass toys. If glass sex toys had any problem, it was breakage. Even children, not just those of ordinary skill, know glass breaks easily. To avoid potential breakage problems, one would look to the prior art to find glass that does not break as easily. They also could look for glass devices used in human orifices such as Pyrex thermometers. Pyrex is the obvious choice for the glass.

4. *The Federal Circuit Was Not Required to Mention Every Ground that Petitioners Wanted*

Petitioners argue issues that the Federal Circuit chose not to discuss. However, no rule requires courts of appeal to discuss every issue a litigant raises. "[C]ourts of appeals should have wide latitude in their decisions of whether or how to write opinions." *Taylor v. McKeithen*, 407 U.S. 191, 194 (1972). Thus, "The failure to discuss particular contentions ... does not mean that the tribunal did not consider them in reaching its decision." *Lowder v. Dep't of Homeland Sec.*, 504 F.3d 1378, 1383 (Fed.

Cir. 2007). "That a court 'do[es] not discuss certain propositions do[es] not make the decision inadequate or suggest the . . . court failed to understand them.'" *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 901 (Fed. Cir. 1984) (*quoting Schilling v. Schwitzer-Cummins Co.*, 142 F.2d 82, 84 (D.C. Cir. 1944)). *See also United States v. Garza*, 165 F.3d 312, 314 (5th Cir. 1999) ("A litigant's right to have all issues fully considered and ruled on by the appellate court does not equate to a right to a full written opinion on every issue raised.").

Petitioners do not seek to have this Court require every appellate opinion discuss every issue that a party might raise. They seek only to require the Federal Circuit to mention some issues they raised. That position shows no compelling reason to grant certiorari. Indeed, to be consistent, petitioners would require the Federal Circuit to discuss the issues Topco raised in its cross-appeal. Petitioners neither explain how to make a workable rule nor give reasons why courts of appeals must discuss every issue simply because one party mentions it.

The Federal Circuit requires district court's findings to be "sufficiently comprehensive and pertinent to the issue in dispute to form a basis for the district court's decision." *Transmatic, Inc. v. Gulton Indus., Inc.*, 53 F.3d 1270, 1276 (Fed. Cir. 1995). *See also* FED. R. CIV. P. 52(a)(1) (requiring district courts to "find the facts specially"). Petitioners do not seek to impose the "sufficiently comprehensive" requirement on all courts of appeals' opinions. They only want the Federal Circuit to discuss all issues that they raised. As Topco showed,

no rule requires appellate courts to discuss every issue. Instead, they have "wide latitude ... whether or how to write opinions." *Taylor*, 407 U.S. at 194.

Moreover, though the Federal Circuit here may not have mentioned the problem and solution explicitly, the opinion infers the problem (potential for glass breaking inside an orifice) and the solution (harder glass—Pyrex). They are so evident anyway that the court had no reason to mention them.

5. *The Federal Circuit's Decision Here Does Not Conflict with Stratoflex, Ruiz or the Unpublished Andersen Case*

No conflict among the circuits can exist because the Federal Circuit decides all appeals from patent infringement actions. *See* 28 U.S.C. § 1295. Nevertheless, petitioners reach out for a purported conflict between the present case and earlier Federal Circuit cases where no conflict exists. The opinions merely dealt with those cases' particular facts.

> This Court grants certiorari to review Federal Circuit precedent where that court establishes a rule that might conflict with statutes or this Court's precedent. *See Cardinal Chem. Co. v. Morton Int'l, Inc.*, 505 U.S. 83, 89 (1993) (reviewing practice of vacating validity counterclaims as moot after holding patent not infringed); *Shinseki v. Sanders*, 129 S. Ct. 1696, 1705 (2009) (reviewing regularly applied, "harmless

> error" framework in appeals from Court of Appeals for Veterans Claims); *KSR*, 550 U.S. at 419 (rejecting Federal Circuit's test requiring a specific "teaching, suggestion and motivation" in the prior art to prove obviousness). Petitioners do not assert that the Federal Circuit ruling here is part of a pattern that conflicts with a statute or this Court's opinions. Thus, they fail to raise compelling reasons to grant their petition.

Petitioners claim three Federal Circuit cases allegedly conflicting with that court's decision here. In the first, *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983), the district court had disregarded alleged evidence commercial success, but the Federal Circuit still upheld the district court's obviousness holding. *Id.* at 1539. Though dicta stated that trial courts should consider all evidence when deciding obviousness, it found no nexus supported the alleged secondary consideration evidence. *Id.* at 1539-40.

Stratoflex and the present case share many similarities. There, the patent solved charge buildups in tubing by using Teflon-carbon black tubing. The inventor consulted a standard text on "conductive carbon black in rubber when he began his search for a solution." *Id.* at 1535. Here, the inventors could have consulted a standard text to find the best glass for sex aids. This was unnecessary because their glass glower already had Pyrex rods and new Pyrex's properties. As

petitioners claim here, "the patent holder in *Stratoflex* claimed "commercial success is shown because: the 'entire industry' makes the tubing ...." The Federal Circuit rejected commercial success evidence because the patent holder failed to show nexus. *Id.* at 1539 ("No evidence of record establishes that tubing covered by the claims of the ... 087 patent was used in the [third party's] retrofit. It cannot therefore be given weight in respect of commercial success.").

Andersen Corp. v. Pella Corp., 2008 U.S. App. LEXIS 24087 (Fed. Cir. Nov. 19, 2008), (unpublished), *cert. denied*, 129 S. Ct. 2739 (2009), cited by petitioners, is unpublished. Therefore, it does not receive "the effect of binding precedent." FED. CIR. R. 32.1(d), The case also is not germane. In reversing a grant for summary judgment, the Federal Circuit held that a prior art reference may not "have been part of the field of invention searched" by a person in the field. *Id.* at *12. The invention claimed using a particular mesh material for window screens. The material's distributor sold it for its electromagnetic properties. The court found evidence that the material "possessed many characteristics that an ordinary skilled insect screen designer would have viewed as undesirable for an insect screen." *Id.* at *12-13. Because the evidence created a material fact issue, the Federal Circuit reversed.

The court only mentioned commercial success in passing. "[W]e need not examine the secondary obviousness factors in any depth." *Id.* at 18.

Here, the prior art included glass sex toys. Pyrex, the alleged improvement in the patent, is the glass having known, desirable properties. Likewise, prior art glass sex toys did not teach away from using Pyrex. At least at the summary judgment stage in *Andersen*, evidence that those of ordinary skill would not consider electromagnetic material for a window screen might raise a material issue to support nonobviousness.

The third case, *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), directly conflicts with *KSR*. There, the Federal Circuit remanded an obviousness holding, in part, because the trial court failed to make specific findings on "the reason, suggestion, or motivation present in the prior art, .. which clearly and particularly would lead one of ordinary skill in the art to combine screw anchors and metal brackets. *Id.* at 660. But *KSR* rejected the rigid "teaching, suggestion and motivation" test. *KSR*, 550 U.S. at 419.

On remand, the district court again held the patent invalid, and the Federal Circuit affirmed. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270 (Fed. Cir. 2004) ("[T]he record also supports the district court's discounting of Chance's evidence of secondary considerations. ... [A]ny commercial success was not due to Chance's alleged unique combination, but rather due to Chance's experience ... combined with being the first large screw anchor manufacturer to enter the underpinning market.") *Id.* at 1277.

H. Conclusion

Petitioners express no compelling reasons for the Court to review obviousness in this ordinary patent infringement case. The Federal Circuit followed an unbroken line of this Court's cases on obviousness including the recent *KSR* case and the 1850s *Hotchkiss* case.

Pyrex, a known, harder replacement for soda-lime glass, performs predictably in sex toys. Therefore, replacing soda-lime glass with Pyrex is obvious.

Consequently, Topco requests that the Court deny the petition for writ of certiorari.

Michael D. Harris
Counsel of Record
Steven C. Sereboff
M. Kala Sarvaiya
SoCal IP Law Group, LLP
310 North Westlake Boulevard, Suite 120
Westlake Village, California 91362
(805) 230-1350 x246 (Telephone)

Counsels for Respondent
Vast Resources, Inc. d.b.a Topco Sales

Dated: August 21, 2009